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Patent Appeal Brief  
Patent 09/876,408

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(LHTLG No. 00,464-A)

In re Application of: )  
Brown ) Examiner: **Nguyen, Tan D.**  
Serial No. 09/876,408 ) Group Art Unit: **3629**  
Filed: June 7, 2001 ) Confirmation No. **7316**  
For: **METHOD AND SYSTEM FOR** )  
**PROTECTING DOMAIN NAMES** )

MAIL STOP: Appeal  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA. 22313-1450

**TRANSMITTAL LETTER**

1. We are transmitting herewith the attached papers for the above identified patent application:

- ☒ **PATENT APPEAL BRIEF under 37 C.F.R. §1.192 (56 pages).**
- ☒ **Exhibits A-F for Patent Appeal Brief (Appendix B) (84 pages).**
- ☒ **Return Postcard, Check for \$250.00.**

2. **FEES:** A check is included for requisite **\$250.00** fee set forth in 37 C.F.R. § 41.20(b)(2) for a small entity under 37 C.F.R. § 1.27(a). The Notice of Appeal under 37 C.F.R. § 1.191 was filed on August 20, 2007.

3. **GENERAL AUTHORIZATION TO CHARGE OR CREDIT FEES:** No other fees or extensions of time are required. Should this assumption be incorrect, if an extension of time is required, consider this a petition and request therefor under 37 CFR § 1.136. Please charge any additional fees (or credit overpayment) to Deposit Account No. **50-2281** for **Lesavich High-Tech Law Group, PC (32097)**.

4. **CERTIFICATE OF MAILING under 37 CFR § 1.10**, the correspondence identified above was deposited with the United States Postal Service as "Express Mail Post Office to Addressee," addressed to the Mail Stop: Appeal, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313 on the **28<sup>th</sup>** Day of **August 2007**. Express Mail Number **EV957083744US**.

Respectfully submitted,

**Lesavich High-Tech Law Group, P.C. (32097)**

Stephen Lesavich, PhD  
Registration No. 43,749

Date: August 28, 2007

**EV957083744US**

LESVICH HIGH-TECH  
LAW GROUP, P.C.  
SUITE 325  
39 SOUTH LASALLE STREET  
CHICAGO, ILLINOIS 60603  
TELEPHONE (312) 332-3751



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Board of Patent Appeals and Interferences  
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**Brown**

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Alexandria, VA 22313-1450

**PATENT APPEAL BRIEF**

**37 C.F.R. §1.192**

**Stephen Lesavich, PhD**

Lesavich High-Tech Law Group, P.C.  
39 S. LaSalle Street, Suite 325  
Chicago, IL 60663

08/29/2007 ATRINH 00000033 09876408

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### **BRIEF OF APPELLANT**

This is a Patent Appeal Brief submitted under 37 C.F.R. § 1.192 to the Board of Patent Appeals and Interferences from the third rejection of all of the claims of the application. This Appeal Brief is accompanied by the requisite fee set forth in 37 C.F.R. § 41.20(b)(2) for a small entity under 37 C.F.R. § 1.27(a). The Notice of Appeal under 37 C.F.R. § 1.191 was filed on August 20, 2007.

This Appeal Brief is also a response to the assertions the Examiner made in the Final Office Action mailed May 18, 2007. The Appellant traverses all of the Examiner's assertions in this Final Office Action. The Appellant may respond to selected assertions by the Examiner, but the Appellant intends to traverse all of the Examiner's assertions in the Final Office Action.

### **REAL PARTY IN INTEREST**

The Appellant, Charles P. Brown, is the real-party in interest.

### **RELATED APPEALS AND INTERFERENCES**

There are no related appeals and interferences known to the Appellant.

### **STATUS OF CLAIMS**

The status of the claims is as follows:

1. Claims at filing: 1-33
2. No Claims have been amended.
3. Claims pending: 1-33.
4. Claims rejected: 1-33.
5. Claims allowed: None.

Thus, the claims on appeal are claims 1-33.

### STATUS OF AMENDMENTS

No amendments have been filed in the application and no amendments have been entered as understood by the Appellant.

### SUMMARY OF THE INVENTION

The numbers in the following text in parenthesis have been added by the Appellant. The numbers without parenthesis appeared in the original application text. The Appellant also includes paragraph numbers from the corresponding U.S. published patent application 2002/0010795 (designated as Pub. [xxxx] ) included as **Exhibit F** for easy reference by the Board.

*A method and system for protecting domain names. A permanent registration certificate for providing a permanent registration of a domain name is issued (FIG. 1, 26). The permanent registration certificate provides a permanent registration of a domain name including perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar (28). A permanent web-site (24) accessible via the Internet (18) and associated with a domain name registration from an issued permanent registration certificate is perpetually hosted. The method and system help prevent a domain name owner from ever losing valuable domain name rights, reduce the burden and administrative overhead placed on domain name owners and more fully utilize existing and new rights associated with a domain name registration. (Application, Abstract, page 48, Pub., page 1).*

*Plural server network devices 20, 22, 24 (FIG. 1) are associated with one or more associated databases are components of a permanent domain name registration system 26. The permanent domain name registration system 26 includes a Purchase/Payment server 20, an Administrative server 22 and a Web-site hosting server 24. The plural network devices 20, 22 and 24 provide system for allowing a "permanent registration" of a domain name. (Application, page 11, lines 14-19, Pub. [0036]).*

*The Purchase/Payment server 20 accepts domain name registration information and handles payment of current and future renewal fees for a domain*

*name. The administrative server 22 helps ensures that the payment has been received by the public domain name registrar by checking for the updated next payment date, verifying payments, determining and solving payment and information discrepancies, etc. The Web-site hosting server 24 allows a domain name for which a permanent registration has been obtained to have a permanent presence on the computer network 18. Thus, the Web-site hosting server 24 can “permanently” host a web-site.*

**(Application, page 12, lines 10-17, Pub. [0036-0039]).**

*FIG. 2 is a flow diagram illustrating a Method 30 for protecting domain name registrations with a permanent registration certificate. At Step 32, information associated with a domain name registration obtained from a public domain name registrar (FIG. 1 28) is accepted on a permanent domain name registration system (26). At Step 34, a one-time permanent registration fee for the domain name registration is accepted on the permanent domain name registration system (26). At Step 36, a permanent registration certificate is issued for the domain name registration based on the accepted information. The permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying future renewal fees for the domain name registration at the public domain name registrar (28) from the permanent domain name registration system (26).*

*Method 30 may also comprise any or all of the additional steps of: issuing a domain name registration title, issuing an insurance policy, issuing plural ownership shares, issuing leases or sub-leases, issuing co-ownership certificates, or creating new or additional rights in the domain name associated with the permanent registration certificate. (Application, page 13 line 20 through Page 14, line 11, Pub. [0044-0045]).*

*In one embodiment of the present invention, the one-time permanent registration fee is added to financial instruments whose profits or interest is used to perpetually pay future renewal fees for the domain name registration. For example, the financial instrument can include an interest bearing account, a certificate of deposit, mutual funds, stocks, bonds, annuities, or other type of financial instrument. (Application, page 13 line 20 through Page 14, line 11, Pub. [0060]).*

*The one-time permanent registration fee is selected such that a first portion of the fee will be used to satisfy current registration fees and administrative costs at the public domain name registrar 28. A second portion of the fee is enough to generate interest or other income through investments and/or the sale of additional goods or services to pay all current and future administrative costs and future registration fees in perpetuity for the domain name registration on the permanent domain name registration system 26. One skilled in the art can determine that the one-time permanent registration fee can be divided into various other portions that are distributed in various ways to cover costs and fees on the permanent domain name registration system 26 and the public domain name registrar 28. (Application, page 18, lines 11-20, Pub. [0061]).*

*FIG. 5 is a flow diagram illustrating a Method 74 for providing a permanent web-site. At Step 76, a domain name for which a permanent registration certificate has been issued is accepted on a permanent domain name registration system (26). The permanent registration certificate provides a permanent registration of the domain name including perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar (28) from the permanent domain name registration system (26). At Step 78, electronic content for a web-site to be associated with the domain name is accepted (18, 24). At Step 80, a one-time permanent web-site fee for hosting the domain name on the permanent domain name registration system(26) is accepted. The one-time permanent web-site fee is used to perpetually host the domain name on the permanent domain name registration system. At Step 82, a web-site (24) accessible via the Internet (18) associated with the domain name is perpetually hosted (24) on the permanent domain name system (28). (Application, page 29, lines 9-21, Pub. [0102]).*

### **GROUPING OF CLAIMS**

Claims 1-33 stand and fall together. A current listing of Claims 1-33 is included in Appendix A.

**ISSUES PRESENTED FOR REVIEW**

1. Whether Examiner Nguyen incorrectly applied U.S. Patent Law numerous times and is treating the Appellant unfairly by not considering the Appellant arguments.
2. Whether Examiner Nguyen correctly applied 35 U.S.C. 103(a) and rejected all of the claims 1-33 over alleged Applicant Admitted Prior Art, that is over the Appellant's patent application itself, in view of Loritzinsky (U.S. Patent No. 6,272,469).
3. Whether Examiner Nguyen correctly applied 35 U.S.C. §112, ¶2 rejection to reject claims 1-13 and 19-24 with an assertion that a claim element is vague and indefinite, the same claim element the Examiner had previously admitted included patentable feature.
4. Whether Examiner Nguyen correctly applied 35 U.S.C. 103(a) and rejected claims 4-5 as being unpatentable over alleged Applicant Admitted Prior Art, that is over the Appellant's patent application itself, in view of Loritzinsky (U.S. Patent No. 6,272,469) and further in view of Mann et al. (U.S. Patent No. 6,519,589) and further in view of Cummings et al. (U.S. Patent No. 6,470,321).
5. Whether Examiner Nguyen correctly applied 35 U.S.C. 103(a) and rejected claims 6-8, 10-11 and 21-22 as being unpatentable over alleged Applicant Admitted Prior Art, that is over the Appellant's patent application itself, in view of Loritzinsky (U.S. Patent No. 6,272,469) and further in view of Burstein et al. (U.S. Patent No. 7,076,541).



## **ARGUMENT for ISSUE 1**

### **INDEPENDENT CLAIMS 1, 14, 19, 25, 30, 32:**

The Appellant repeats its traverse of all the assertions made by the Examiner in the First Office Action, Second Office Action and Third Final Office Action.

In a First Office Action (page 2) the Examiner rejected all of the claims of the application under 35 U.S.C. 101. The Examiner asserted that “The U.S. department of commerce, working under the authority of Congress, is under contract with ICANN for the domain name registration, and therefore has no authority to grant a patent to a system that they have no jurisdiction over. Claims 1-33 are rejected on ground that they infringe on U.S. laws set forth by Congress.”

This is a first instance of the Examiner’s improper application of U.S. Patent laws and lack of understanding of the domain name registration system and the Appellant’s claimed invention.

In a First Response (pages, 2-5) the Appellant traversed this 101 rejection and conducted a simple patent search and determined that the United States Patent and Trademark Office (USPTO) has issued at least seven patents that include the terms “domain name registration” in the claims. In addition, there were 25 pending USPTO published patent applications what include the terms “domain name registration” in their claims.

The Examiner could have easily conducted such a search himself. In addition, one of the issued patents, Mann (U.S. Patent No. 6,519,589), cited

by the Examiner for a 103 rejection used to reject the claims included an invention including a system for generating the text for domain name and for facilitating its registration with a public domain name registrar. The Appellant argued that if trying to patent inventions related to domain name registrations really did infringe on laws set by Congress the U.S. Patent Office would not have granted any such patents or accepted and published so many additional patent applications related to the same topic.

In a Second Office Action (page 2) the Examiner withdrew this nonsensical 101 rejection.

In the First Office Action (page 3) the Examiner also rejected Claims 1-13 and 19-34 under 35 U.S.C. 103(a) as being unpatentable over alleged *Applicant Admitted Prior Art (AAPA)* in view of *Mann* (U.S. Patent No. 6,519,589) in view of *Koritzinsky* (U.S. Patent No. 6,272,469) in view of *Hagan* (U.S. Patent No. 6,415,267).

The Examiner asserted “As for claim 1 Applicant Admitted Prior Art (AAPA) fairly discloses the method of registration is well known. “ (First Office Action, page 4, paragraph 1). In other words, the Examiner asserted he was rejecting the Appellant’s invention in Claim 1 over the invention disclosed in the Appellant’s own application. This is a second instance of the Examiner’s improper application of U.S. Patent laws and lack of understanding of the domain name registration system and the Appellant’s claimed invention.

The Applicant traversed this rejection submitted that there was no AAPA as alleged by the Examiner and provided eight (8) pages of arguments as to why the claimed invention was not obvious (First Response, pages 5-13).

In the Second Office Action (page 2, paragraph 1) The Examiner then asserted the Applicant's 103 response arguments were "not persuasive."

However, after reading the Appellant's response to the assertions, the Examiner apparently withdraw with the First 103 Rejection without explanation created a brand new Second 103 Rejection.

In the Second 103 Rejection he rejected Claims 1-3, 9, 12-13, 14-18, 19-20, 23-24, 25-29 30-31 and 32-33 under 35 U.S.C. 103(a) as being unpatentable of alleged AAPA in view of Koritzinsky (U.S. Patent No. 6,272,469). (Second Office Action, page 3, paragraph 5).

The Board will note that for this second 103 rejection, the Examiner dropped *Mann* and *Hagan* from the rejection, even though the Appellant's arguments were "deemed unpersuasive."

This is a third instance of the Examiner's improper application of U.S. Patent laws and his lack of understanding the domain name registration system and the Appellant's claimed invention.

With respect to Claim 1, the Examiner then asserted the Appellant's own application is "alleged APPA" and teaches all of the claimed inventions in the Background of the Invention in the specification specifically on page 3 in the last two paragraphs, page 3, lines 19-21 and page 4, last paragraph. (Second Office Action, page 5). *This is simply not true.* All the Appellant did in the Background section of the application was to describe some background information and list some problems associated with domain names.

Claim 1 teaches:

*1. A method for protecting domain name registrations with a permanent registration certificate, comprising:*  
*accepting information associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system;*  
*accepting a one-time permanent registration fee for the domain name registration on the permanent domain name registration system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration; and*  
*issuing a permanent registration certificate for the domain name registration based on the accepted information, wherein the permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system.*

Lines 19-21 and last two paragraphs and of page 3 of the Appellant's application teach:

*Another problem is that the current system of Internet domain ownership does not confer ownership in the traditional sense of the word. What is now referred to as "domain name ownership" is really just a right to use a domain, provided that the registration fee is current. An entity that "owns" a domain name retains the right to use that domain name by paying the registration fee on time. Otherwise the usage rights to the domain name are forfeited and the domain name returns to the general pool of domain names available for anyone to register and acquire usage rights.*

*Network Solutions, Inc. ("NSI") under contract with the National Science Foundation was the exclusive registrar of TLD's from 1993-1998. The Internet Corporation for Assigned Names and Numbers ("ICANN") was established in 1998 to move the administration of the DNS to the private sector. There are now many different approved organizations that can register domain names in association with ICANN. For example, a domain name can be registered electronically at nsi.com, register.com, namedroppers.com, domainnameregistration.com, budgetregister.com and other web-sites on the Internet.*

*There are a number of problems associated with the current system of registering domain names. One problem is that the current system of registration fees for Global TLDs is designed to ensure that there is money available each year from each domain to contribute to the support of the registry/registrar system and the DNS. To achieve the purpose of ensuring funding and that each domain contributes to the system each year. This system establishes a monetary self-sufficiency for the registration system, but at the cost of administrative overhead and business risk for the users of the system.*

The last paragraph of page 4 of the Appellant's application teaches:

*Another problem is that domain names have become valuable entities unto themselves, far out of proportion in value to the cost of an annual registration fee. Some domains have a commercial value of millions of dollars, but non-payment of a single \$35 payment can result in the loss of valuable rights and will disconnect a web-site at a domain name address.*

The Board can clearly see that none of the claim elements are recited in this section of the Appellant's application as asserted by the Examiner. These sections cited by the Examiner do not include any reference to the permanent domain name registration system and permanent website hosting system claimed by the Appellant.

Thus, these cited paragraphs and nothing else in the Background section of the Appellant's application are certainly NOT the alleged AAPA as applied to the claimed invention. None of these sections teach or suggest any feature at all related to the permanent domain name registration system recited by the other claim elements. This is clearly a serious error in the application of U.S. Patent law by the Examiner.

The Examiner then did something that the Appellant has never seen before in his whole career as a patent attorney. The Examiner wrote his own claim with his own words which he extracted from the prior art reference Koritzinsky (Second Office Action, page 4) to provide a basis for his 103 rejection where none actually exists.

The Board certainly understands that the role of the Examiner under MPEP §706 is to examine the claims of patent applications written by applicants' and not to

draft claims for the applicant and not to draft claims and assert them over an applicant's claims.

The Board is requested to review Table 1 including Claim 1 as filed by the Appellant and the contrived claim crafted by the Examiner to support his rejections using words he extracted from Koritzinsky.

Claim as filed by Appellant	CLAIM 1 written by the Examiner:
<p>1. A method for protecting domain name registrations with a permanent registration certificate, comprising:</p> <p>accepting information associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system;</p> <p>accepting a one-time permanent registration fee for the domain name registration on the permanent domain name registration system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration; and</p> <p>issuing a permanent registration certificate for the domain name registration based on the accepted information, wherein the permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration</p>	<p>1. A method for protecting a subscription service with a permanent service certificate, wherein the service is domain name registrations subscriptions, comprising:</p> <p>accepting information associated with a subscription service, wherein the subscription service is domain name registration obtained from a public domain registrar on a domain name registration system;</p> <p>accepting a one-time permanent registration fee for the subscription service wherein the subscription service is domain name registration, on a permanent subscription service system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the subscription service; and</p> <p>issuing a permanent service certificate based on the accepted information, wherein the subscription service is domain name registration, and the permanent service certificate is about domain name registration the certificate provides a permanent registration the domain name registration including perpetually determining paying and verifying current and future renewal fees due for a domain name registration at the public domain name registrar from</p>

system.	the permanent domain name registration system.
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Table 1.

As ridiculous as this exercise is, the Examiner then, in a totally self-serving manner asserts that the new claim he wrote with the own words extracted from Koritzinsky *reads over* Appellant's invention recited by Claim 1. (Second Office Action, page 4). Thus, the Examiner asserts the Appellant's invention is obvious over the combination over the alleged AAPA (which as is explained above is NOT true) and Koritzinsky.

What the Board can easily see is that the Examiner is trying to add features to the Appellant's claimed invention that are not necessary to practice the Appellant's invention. The Appellant's invention has no need for the features added to the Appellant's claim by the Examiner. The Appellant's invention already includes claim new, novel and non-obvious elements for a permanent domain registration system and permanent website hosting system and has no need for the elements added by the Examiner from Koritzinsky that related to paying fees for a subscription to medical imaging systems.

In addition, so what. If this claim written by the Examiner reads over the Appellant's claim, which it clearly does not, the claim was written by the Examiner. The claim was not written by the Appellant. It was not written Koritzinsky. It does not appear in any prior art reference. It was written by the Examiner in violation of patent rules. A very interesting new tool for Examiners to use. Write their own claims and assert their own claims read over those filed by an applicant.

Further, the Board will note that all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). The Examiner has not considered all words in the claims drafted by the Appellant. Instead the Examiner has drafted his own claim and is considering his own words to artificially support his own rejections.

This is a fourth instance of the Examiner's improper application of U.S. Patent laws and his lack of understanding of the domain name registration system and the Appellant's claimed invention.

Based on the improper self-serving analysis the Examiner then asserted the Appellant admitted all of the elements of Claim 1 alleged AAPA (NOT true as discussed above) except for one.

The Examiner then concedes that the Appellant's alleged AAPA did not teach or suggest the second element of Claim 1: *accepting a one-time permanent registration fee for the domain name registration on the permanent domain name registration system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration.*

The Board will also note that if the alleged AAPA did not teach this claim element it could not have taught the other elements of Appellant's Claim 1 because the other elements include the claim limitations of a *permanent domain name registration system*.

The Examiner further asserted the whole invention was taught "except for the type of fee payment for subscription (registration) service from annual payment (\$35.00/year) to a one-time permanent registration fee with would result in an



issuing of a permanent registration certificate, for example a payment of \$3,500 to cover 100 years or a \$1,000,000 for perpetually permanent service.”

The statement also illustrates how the Examiner does not really understand the Appellant’s claimed invention. The last paragraph of page 4 of the Appellant’s application cited above states annual domain name registration fees are \$35 and are paid to a public domain registrar and that selected domain names have a commercial value of millions of dollars, not someone paying millions of dollars to renew domain names in a single payment as no one could or would attempt to do.

The Appellant’s invention in part teaches a one-time permanent registration fee payment to perpetually pay all future renewal fees for the domain name registration and/or web-site hosting. A current payment actually charge by the Appellant’s for use of the claimed invention is hundreds of dollars (e.g., \$995, etc.). A portion of the few hundred dollars is used to pay domain name registration and website hosting renewal fees in the short term. The remaining portion of the permanent registration fee is invested and the investment income to used to pay renewal fees for the long term.

As a practical matter, no one would submit \$1,000,000 as the Examiner suggests because no rational person would use such a large some of money to renew domain names and such a large fee is not necessary to practice the claimed invention. However, even if a \$1,000,000 fee were paid to a public domain register, it would NOT provide the permanent domain name and website hosting system as claimed by the Appellant. When the \$1,000,000 fee is exhausted, the domain name registration would require someone pay additional funds to maintain it.

The Appellant in part, has an actual business for providing a permanent memorial web-site for deceased people and pets that provides an “electronic tombstone” on the Internet for perpetuity based on the claimed invention.

However, Examiner then asserts for the first time in the Second Office Action that the claim element “accepting a one-time permanent registration fee,” the very claim element he considered to be novel, is also now vague and indefinite and rejected Claim 1 (as well as claims 1-13 and 19-24) with a 35 U.S.C. §112, ¶2 rejection. This is the only claim element of Claim 1 (and Claim 19) that the Examiner admitted was a new unique, novel and nonobvious feature.

The Board will note the Examiner did not raise this rejection in the First Office Action. The Examiner, appears to requiring the Appellant to modify one of the Appellant’s claim element of Claim 1 and 19 that to fit into the Examiner’s 103 rejection scheme, the Examiner’s own claim and for alleged AAPA in view of Koritzinsky to strengthen the Examiner’s ability to maintain his improper rejections. Something really stinks here.

The Examiner also asserts Koritzinsky teaches a subscription service with various types of payments for medical image systems is the same as the Appellant’s invention for domain name registrations, *even though Koritzinsky does not teach, suggest or even mention domain names or registrations of domain names, period.* The Examiner then, to further bolster his position, decides *sua sponte* that “the type of subscription service is not critical since fee payment arrangements can be applied in any subscription service.” The Examiner further asserts that “as for the difference in the type of subscription service, again, this is not critical and within the skill of the artisan.” (Second Office Action, page 6). Thus, the Examiner has come full

circle in his circular logic and has concluded that any fee payment system makes the Appellant's claim permanent domain name registration system obvious because a claim element the Examiner deemed patentable is really not critical all to anything. The Examiner also decides only what he thinks is "critical" without any proof or basis under the patent rules or fact.

In the Second Office Action, a second non-final rejection, the Examiner also did a new search and created new 103 rejections with new references including Cummings and Burstein (Second Office Action, pages 8-9). A new search was not appropriate or necessary since the Applicant did not amend the claims and the Examiner withdraw a least a portion of his 103 rejections even though he stated the Appellant's arguments were "unpersuasive."

These actions by the Examiner violated MPEP rule 706.07. MPEP Rules 706.07 clearly states:

*To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; Switching from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.*

The Examiner did not allow any claims or finally reject any claims in this second non-final office action.

In a Third Final Office Action (page 11) the Examiner also complains that he sent two previous office actions for and the Final office action with the same assertions and the Appellant did amend any of the claims.

The Examiner then the audacity now to assert that the Appellant's arguments in the previous two responses "*fail to comply with 37 C.F.R. 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out the how the language of the claims patentably distinguishes them from the references.*" (Third Final Office Action, page 10, paragraph 12).

This assertion also shows the Examiner is clearly biased toward the Appellant and is not fairly considering the Appellant's arguments and has not considered the Appellant's arguments at all.

The Board is now urged to turn to the Exhibits and review the First and Second Responses filed by the Appellant.

The Appellant submitted a First Response that was 19 pages long that clearly, concisely and explicitly how the claims were patentably distinct from the references cited by the Examiner based on current case law and the patent rules. The Appellant submitted a Second Response that was 15 pages long that clearly, concisely and explicitly how the claims were patentably distinct from the references cited by the Examiner based on current case law and the patent rules. The Appellant has submitted a total of 34 pages of well reasoned legal arguments yet the Examiner still asserts the Appellant has not specifically pointed out how the language of the claims patentably distinguishes the claims from the cited references. Also, the Examiner withdraw his rejections to *Mann* and *Hagen* and then makes such a biased assertion.

In addition, three office actions with incorrect application of U.S. Patent Law are just that: three bad office actions with incorrect application of U.S. Patent Law.

The Appellant can only respond in a very limited number of ways to a clear misapplication of U.S. Patent Laws.

The Board must correct the Examiner's misapplication of U.S. Patent Law and unfair treatment of the Appellant and must not allow such mistakes and behavior to continue.

### **CONCLUSION FOR ISSUE 1**

Based on these remarks, the Appellant now requests the Appeal Board instruct the Examiner to immediately withdraw all rejections and immediately pass all the claims to allowance. In the alternative, if the Board feels the claims are not ready for allowance the Appellant requests the application be passed to another Examiner who will at least treat the Appellant fairly.

## **ARGUMENT FOR ISSUE 2**

The Examiner has rejected Claims 1-3, 12-13, 14-18, 19-20, 23-24, 25-29, 30-31 and 32-33 as being unpatentable under 35 U.S.C. §103(a) over alleged Applicant Admitted Prior Art (AAPA) in view of Koritzinsky (U.S. Patent No. 6,272,469).

### **INDEPENDENT CLAIMS 1, 14, 19, 25, 30, 32:**

The Appellant repeats its traverse of all the assertions made by the Examiner in the First Office Action, Second Office Action and Third Final Office Action.

As was discussed in detail above, the Appellant did not admit any of the claim elements of the claimed invention in the Background section of the application. All the Appellant did was provide a general background discussion. There is no AAPA that describes the claimed invention. Period. Enough said. As a result, the 103 rejection is improper on its face since Koritzinsky does not teach suggest or even mention domain names. Thus, the Examiner has clearly not provided a *prima facie* basis for obviousness under 35 U.S.C. §103(a)

Thus, the Appellant really need not respond any further. However, the Appellant responds as follows to point out all the remaining errors in the Examiner's assertions for the Board.

To establish a *prima facie* case of obviousness in the first place, three basic criteria must be met. First, there must be some suggestion or motivation, either in

the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

**I. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.**

There are three possible sources for a motivation to combine references: (1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

**a. The nature of the problem to be solved:** The problem in general, solved by the Appellant's invention was to provide a way for a person to pay a small amount of money to provide a permanent domain name registration and/or permanent web-site hosting. The small amount of money would be invested and investment income would be used to pay renewal fees in perpetuity. The claimed invention helps ensure that an important domain name would not be lost for failure to pay renewal fees. The claimed invention also provides a way for a person to provide a perpetual electronic memorial on the Internet for a deceased relative or pet.

The Examiner cites the Background section of the Appellant's patent application as teaching the claimed invention. The Examiner specifically cited page 3, lines 19-21, page 3, last two paragraphs and pages 4-6 of the Appellant's application. As was discussed above and illustrated by the exact sections the Examiner cited, the Appellant did NOT admit the invention in the Background section. The Appellant did nothing more than describe the nature of the problem to be solved and provide general information about how a domain name is registered.

The Examiner cited no other prior art period other than the Appellant's own patent application that discussed the solution the problem solved by the Appellant's invention, namely, a permanent domain name registration and/or website hosting system.

The Examiner then seeks to combine the Appellant's own patent application with Koritzinsky which teaches medical diagnostic and imaging systems which are configured to execute protocols for examinations, image acquisition, and so forth. More particularly, the invention relates to a technique for making such protocols available to a system user, for easily selecting such protocols and installing them for use, and for transmitting protocols to diagnostic systems where they can be executed. (Col. 1, lines 5-12).

The Examiner asserts that since the Appellant has allegedly admitted the claimed invention in the Background section of the application (which is simply NOT true) and Koritzinsky teaches at (col. 21, lines 15-50) a subscription service for the medical diagnostic systems that allows pay-per-use and yearly fees for a license the combination of the two has solved the problem of providing a permanent domain name registration system.



*Koritzinsky does not teach, suggest or even mention domain names or domain name registrations, anywhere, period.* Koritzinsky teaches or suggests nothing that can be used to solve the problems the Appellant has solved with the claimed inventions.

Combining the Appellant's own application with Koritzinsky is clearly an erroneous assertion by the Examiner in violation of the first prong of *In re Rouffet* and thus there is no motivation to combine the references based on the nature of the problems to be solved.

**The teachings of the prior art:** Koritzinsky teaches "an Imaging system protocol handling method and apparatus" (Title) and "A technique is disclosed for providing programs, such as operational protocols, to medical diagnostic institutions and systems. The protocols are created and stored on machine readable media. A description of the protocols is displayed at the diagnostic institution or system. A user may select a desired protocol or program from a user interface, such as a listing of protocols. The protocol listing may include textual and exemplary image descriptions of the protocols. Selected protocols are transferred from the machine readable media to the diagnostic institution or system. The transfer may take place over a network link, and may be subject to fee arrangements, subscription status verifications, and so forth. Protocols may be loaded for execution on system scanners by selection from the same or a similar protocol listing screen." (Abstract). Thus, Koritzinsky primarily teaches handling protocols of medical imaging services. Koritzinsky does not teach, suggest or even mention domain names or domain name registrations, anywhere, period. Thus, there is no motivation or suggestion in

Koritzinsky whatsoever to provide a permanent domain registration and/or website hosting system.

The Appellant's invention has no connection whatsoever to medical diagnosis systems or protocols for medical imaging services and does not teach or suggest renewing subscriptions to such medical diagnosis systems. Thus, there is no motivation or suggestion in the Appellant's application to provide renewal subscriptions to medical imaging services.

Combining the Appellant's application with Koritzinsky is clearly an erroneous assertion by the Examiner in violation of the second prong of *In re Rouffet* and thus there is no motivation to combine the references based on the teachings of the prior art.

**The knowledge of persons of ordinary skill in the art:** Koritzinsky was filed in 1998. The Appellant's application was filed in June of 2001 claiming priority to a provisional patent application filed in June of 2000.

The Examiner asserts it would have been obvious to modify the Appellant's invention for a permanent domain registration system with a fee payment system for subscriptions to medical imaging services at the time the invention was made to make the claimed invention obvious based on the combination.

The Examiner must determine the knowledge of the persons of ordinary skill in art at the time the application was filed. To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. Knowledge of applicant's disclosure must be put aside in reaching this determination. The references must be viewed without the

benefit of impermissible hindsight vision afforded by the claimed invention and not based on applicant's disclosure. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5 (Fed. Cir. 1986) and *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

In an article entitled the "History of the Internet" on Wikipedia, the free Internet encyclopedia at the URL [http://en.wikipedia.org/wiki/History\\_of\\_the\\_Internet](http://en.wikipedia.org/wiki/History_of_the_Internet), teaches on September 18, 1998 both IANA and InterNIC were reorganized under the control of ICANN, a California non-profit corporation to manage a number of Internet-related tasks. The role of operating the Domain Name System (DNS) system was privatized and opened up to competition, while the central management of name allocations would be awarded on a contract tender basis at a later time (1999, see below).

In another electronic article at the URL [http://en.wikipedia.org/wiki/Domain\\_name\\_registrar](http://en.wikipedia.org/wiki/Domain_name_registrar) entitled "Domain Name Registrars" teaches until 1999, there was no Shared Registration System (SRS). Network Solutions (NSI) operated the .com, .net, and .org registries, and was the de jure registrar and registry. However, several companies had set up as de facto registrars, including NetNames, who invented the idea of a commercial standalone domain name registration service in 1996. Registrars formed another link in the food chain, introducing the concept of domain name sales, effectively introducing the wholesale model into the industry. NSI followed suit, forcing the issue of separation of Registry and Registrar. In October 1998, following pressure from the growing domain name registration business and other interested parties, NSI's agreement with the US Department of Commerce was amended, requiring the creation of an SRS that supported multiple registrars. The SRS officially opened on November 30, 1999.

The Appellant's application discloses similar information about the domain name registration system in the United States.

Koritzinsky was filed by GE Medical Systems on November 25, 1998, just one month after the DNS system in the United State was privatized and a full year

before there was a domain name registration business with multiple public registrars. It is highly unlikely that Koritzinsky an inventor a GE Medical involved with inventing medical imaging systems or any other person similarly skilled in the art in 1998 would have had conceived the Appellant's invention with just knowledge of the Koritzinsky invention including subscription services and domain names available from public registrars when the multiple public domain registrars didn't stop operating until a year later.

It is also highly unlikely that any other person skilled in the art, would in June of 2000, when the Appellant's provisional was filed would have created an invention as taught by the Appellant's claimed invention or could have included subscription services for medical imaging systems as taught by Koritzinsky when multiple public domain name registrars had only been operating for less than year to publicly register domain names at all.

In addition, Koritzinsky didn't issue in the United States until August 7, 2001, a month after the Appellant's Utility application was filed. The Appellant can find no evidence that the Koritzinsky was published in the United States at all is its filing preceded the AIPA of 1998 and the requirement that "Publication of patent applications is now required for the vast majority of filings made on or after November 29, 2000." Thus, no one skilled in the art, could have known about the Koritzinsky invention and used it to create new inventions.

The Examiner has not met his burden under the holdings of *Hodosh v. Block Drug Co., Inc., etc.* and *In re Mills*.

Stating one skilled in the art could have combined the Appellant's application with the Koritzinsky invention is clearly an erroneous assertion by the Examiner in

violation of the third prong of *In re Rouffet* and thus there is no motivation to combine the references based on knowledge of one of ordinary skill in the art at the time the Appellant's invention was filed.

In addition, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986 (Fed. Cir. 2006).

The Federal Circuit emphasized that the proper inquiry for suggestion or motivation for an obviousness rejection is "whether there is something in the prior art as a whole to suggest the *desirability*, and thus the obviousness, of making the combination, *In re Fulton*, 391 F.3d 1195 (Fed. Cir. 2004).

"A statement that modifications of the prior art to meet the claimed invention would have been "*well within the ordinary skill of the art at the time the claimed invention was made* because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000).

The Examiner has not met his burden under the holdings of *In re Kahn*, *In re Fulton* *Ex parte Levengood* or *In re Kotzab*. In fact the Examiner simply states the Appellant's application can be combined with Koritzinsky simply because "the type of subscription service is not critical since fee payment arrangements can be applied in any type of subscription service. (Second Office Action, page 6).

There is nothing in the prior art, including anything in the Background section of the Appellant's application that suggests modifying the Appellant's invention to include paying fees for subscription services for medical imaging systems as is taught by Koritzinsky. Its simply not necessary.

There is nothing in Koritzinsky either to suggest modifying Koritzinsky to create a permanent domain name registration since Koritzinsky does not teach, suggest or even mention domain names or domain name registrations. Period.

Thus, There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings based on the holding of the first prong of *In re Vaeck*.

**II. There is no reasonable expectation of success to combine the Appellant's invention with Koritzinsky.**

Evidence showing there was no reasonable expectation of success supports a conclusion of nonobviousness. *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976).

There is no reason to include a subscription service for maintaining medical imaging systems with the Appellant's invention and there would not be any expectation of success of doing so. Koritzinsky includes a complex architecture specifically for medical imaging. (See FIGS. 1-16). Kortizinsky does not teach suggest or even mention domain name registrations.

There is no reason to include the components of Appellan'ts application in Koritzinsky since nothing taught by Koritzinsky is necessary to practice the Appellant's invention. The Appellant's invention teaches a different complex

architecture specifically for providing a permanent domain registration system and permanent website hosting system.

Thus, there is no reasonable expectation of success to combine the Appellant's invention with Koritzinsky or Koritzinsky with the Appellant's invention. This supports a conclusion of nonobviousness under the holding of *In re Rinehart*.

Thus, there is no reasonable expectation of success to combine the references as the Examiner suggests based on the holding of the second prong of *In re Vaeck*.

**III. The prior art reference (or references when combined) do not teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success are not found in the prior art, but instead are improperly based on Appellant's disclosure.**

Since the Examiner has not found any relevant prior art, the Examiner is relying heavily on the Appellant's own application to support his rejections.

The Examiner makes the following convoluted incorrect assertions to argue that Kortizinsky combined inappropriately with alleged AAPA teaches the claimed invention even though Kortizinsky does not teach suggest or even mention domain name registrations at all:

*"In another subscription service, KORITZINSKY et al discloses several types of fee payment options (financial management arrangements) that may be provided to the subscriber for different levels of service, such as (a) pay-per-use, (b) periodically (yearly), or (c.) permanently, such as lifetime or non-expiring warranty service {see col. 21, lines 1 5-50}. In view of the general problems with respect to the expired subscribed service for the domain name registration as mentioned in the AAPA, it would have been obvious to modify the yearly/annual fee payment teachings of AAPA with a permanent fee payment as taught by KORITZINSKY et al to obtain the benefit of lifetime or non- expiring warranty service. Note that the type of subscription service in KORITZINSKY et al deals with subscribing to diagnostic system/service, however, the type of service or subscription service is not critical since fee payment arrangement can be applied in any subscription service. Moreover, the critical issue is "fee payment option" and facing with the problem of expiring of service due to non-payment, a skilled artisan would look to the teachings of fee payment options or different levels of service and if the service is so critical while the fee payment is so*

*cheap, one would pick the permanent or lifetime or non-expiring warranty service to insure lifetime service. As for the difference in the type of subscription services, again, this is not critical and within the skill of the artisan since the major issue is the types of fee payment options for different levels of service. As for the limitation of “wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration”, this reads over the limitation “lifetime or non-expiring warranty service” of KORITZINSKY et al and is therefore inherently included in the teachings of KORITZINSKY et al above.”*

*In response to applicant’s argument that AAPA and KORITZINSKY et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, it would have been obvious to modify the yearly/annual fee payment teachings of AAPA with a permanent fee payment as taught by KORITZINSKY et al to obtain the benefit of lifetime or non-expiring warranty service. Note that the type of subscription service in KORITZINSKY et al deals with subscribing to diagnostic system/service, however, the type of service or subscription service is not critical since fee payment arrangement can be applied in any subscription service. Moreover, the critical issue is “fee payment option” and facing with the problem of expiring of service due to nonpayment, a skilled artisan would look to the teachings of fee payment options or different levels of service and if the service is so critical while the fee payment is so cheap, one would pick the permanent or lifetime or non-expiring warranty service to insure lifetime service. As for the difference in the type of subscription services, again, this is not critical and within the skill of the artisan since the major issue is the types of fee payment options for different levels of service and subscription to diagnostic service is one of many teachings cited by KORITZINSKY et al. As for the limitation of “wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration”, this reads over the limitation “lifetime or non-expiring warranty service” of KORITZINSKY et al and is therefore inherently included in the teachings of KORITZINSKY et al above. (Third Final Office Action, pages 6 and 7, pages 9 and 10, paragraph 11).*

The Board will note the Examiner spends many words trying to convince the Appellant that the Appellant’s claimed invention actually needs the unnecessary features for medical imaging systems taught by Koritzinsky. Of course none of these features is necessary since the Appellant’s claimed invention already has the appropriate the features for providing a permanent domain name registration



system and a permanent website hosting system. It simply does not need any features taught by Koritzinsky.

To establish *prima facie* obviousness of a claimed invention in the first place, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974).

The Board should note that even after this convoluted assertion the Examiner has not stated how the combination of alleged AAPA and Koritzinsky explicitly teaches all of the claim elements in violation of the holding of *In re Royka*.

In fact the Examiner admits that the Applicant's application does not teach "a one-time permanent registration fee which would result in an issuing of a permanent registration certificate." (Second Office Action, page 5).

By the Examiner's own words and admissions not all of the claim limitations have been taught by alleged APPA alone or in combination with Koritzinsky.

The Examiner has thus clearly not established a *prima facie* case of obviousness for the claimed invention in violation of the holdings of *In re Royka*. Thus, Claim 1 is not obvious and the Section 103 rejection should be immediately withdrawn.

The Examiner is also appearing to rely on words he selected for the claims he wrote himself and the teachings of Koritzinsky being equivalent and inherent to those claimed by the Applicant. The Examiner is reminded that in order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and **cannot be based on applicant's disclosure** or the mere fact that the components at issue could be functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958) (or

based on words the Examiner makes up himself and claims are equivalent without any proof).

The Examiner asserted the Appellant's claim limitation of a "one time permanent registration fee used to perpetually pay all future renewal fees for the domain name registration" reads over Koritzinsky "a lifetime or non-expiring warranty service" and is inherently included in the teachings of Koritzinsky. (Third Final Office Action, page 7). The Examiner also asserted that the term "receipt" of the service request of Koritzinsky reads over the limitation "a permanent registration certificate" and is inherently included. These are clearly incorrect assertions. When does a "receipt" as taught by Koritzinsky suddenly rise to the level of a permanent registration certificate?

To establish inherency in the first place, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

The Examiner fails the equivalence and inherency tests because Koritzinsky does not teach, suggest or even mention domain names or domain name registrations. The Examiner has not provided any other prove from the prior art, other than the Appellant's own application that such an equivalence or inherency exists.

In fact, if the Board goes back and re-examines Table 1, the Board will see that the Examiner added to the claim he wrote the claim elements from Koritzinsky

that he later asserts are equivalent and inherent in the Appellant's claims. If such elements were truly equivalent and inherent, the Examiner would have not tried to make them additional claim elements that were added to the Appellant's claims as additional features.

The Examiner clearly has not met the burden of proof for equivalence under the holding of *In re Ruff* or for inherency under *In re Robertson*. No person skilled in any art, when viewing the teachings of Koritzinsky that teaches providing medical imaging system protocols for medical imaging system services and does not teach, suggest or even mention domain names, would inherently find a permanent domain name registration certificate or permanent domain name registration system or any of the other additional limitations described by the claimed invention.

The improper cite to alleged AAPA and Koritzinsky still does not teach all of the claim limitations, either explicitly or inherently as the Examiner suggests based on the holding of the third prong of *In re Vaeck*.

***Other Rejected Dependent Claims:***

The Examiner makes many assertions for the dependent claims that the features taught are inherent and obvious because the features are well known practices over the Internet.

The Applicant traverses these assertions because the none of these practices were well known at the time the Appellant's application was filed in 2001. In addition, none of these practices were obvious when fully considered with all of the limitations of the corresponding independent claims as described above and at the time the Appellant's application was filed. In addition, the Examiner again

improperly rejects the Appellant's claims over the Appellant's own application and alleged AAPA, which there is none.

The Appellant has also made arguments with respect to Independent claims 1, 14, 19, 25, 30 and 32. See previous pages. Thus, the Appellant has specifically pointed out the error's in the Examiner's assertions. The Appellant also requests the Board instruct the Examiner to provide proof from the prior art, and not from the Appellant's own application proofing these features were well known under 37 C.F.R. 1.104(c)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, the Board understands if an independent claim is non-obvious under 35 USC 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988). All of the dependent claims add additional limitations not present the independent claims. The Appellant has clearly pointed out why the independent claims not obvious. Thus, the dependent claims are not obvious either under the holding of *In re Fine* and their rejections must be immediately withdrawn.

### **CONCLUSION FOR ISSUE 2**

Thus, the obviousness rejection is clearly improper under the holdings of *In re Vaeck* and the large number of other holdings cited herein. Therefore, the Examiner clearly has not established a *prima facie* case of anticipation under §103(a). Therefore, the Appellant now requests the Appeal Board instruct the Examiner to immediately withdraw the §103(a) rejections with respect to the cited claims. Since none of these claims is not obvious they should be immediately allowable in their present form.

### ARGUMENT for ISSUE 3

The Examiner rejects claims 1-13 and 19-24 under 35 U.S.C. §112, 2<sup>nd</sup> paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 5, the 2<sup>nd</sup> step of ‘accepting a one-time permanent registration fee’ is *vague and indefinite*. From the specification, it appears this phrase appears to mean “accepting a one-time permanent registration fee payment” and therefore, insertion of the term “payment” after “fee” is recommended to improve clarity. Similarly, claims 19-24, are rejected for the same reasons set forth in claims 1-13 above.” The Appellant traverses this rejection.

All of the arguments for Issues 1 and 2 are incorporated herein by reference. The Board will note that the Examiner has rejected a portion of the Appellant’s claim that the Examiner admitted was not taught by any of the cited or alleged prior art as now being vague and indefinite.

The test for definiteness under 35 U.S.C. 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, (Fed. Cir. 1986).

The cited portions of Claims 1 and 19 clearly meet this test for definiteness under the holding of *Orthokinetics, Inc.* The Examiner’s own words support the Appellant has met the burden of this test.

In addition, the Board will note Examiner by his own words clearly violated the patent rule cited forth in MPEP §2173.02. This rule states “that if the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second

paragraph, but the Examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the Examiner should suggest improved language to the applicant...*If the applicant does not accept the Examiner's suggestion, the Examiner should not pursue the issue.*" MPEP §2173.02

### **CONCLUSION FOR ISSUE 3**

Thus, the 35 U.S.C. 112, second paragraph is clearly improper. Therefore, the Appellant now requests the Appeal Board instruct the Examiner to immediately withdraw the 35 U.S.C. 112, second paragraph with respect to the cited claims.

**ARGUMENT for ISSUE 4**

The Appellant traverses the Examiner's rejection. All of the arguments for Issues 1 and 2 discussed above are incorporated herein by reference.

As was discussed in detail above, the Appellant did not admit any of the claim elements of the claimed invention in the Background section of the application. All the Appellant did was provide a general background discussion. There is no AAPA that describes the claimed invention. Period. Enough said. As a result, the 103 rejection is improper on its face since Koritzinsky does not teach suggest or even mention domain names. Thus, the Examiner has clearly not provided a prima facie basis for obviousness under 35 U.S.C. §103(a)

Thus, the Appellant really need not respond any further. However, the Appellant responds as follows to point out all the remaining errors in the Examiner's assertions for the Board.

The Board is asked to turn to Appendix B and review the Appellant's response to these references in Appellant's First Response and Second Response.

The Examiner makes many assertions for these dependent claims that the features taught are inherent and obvious because the features are well known practices over the Internet and otherwise.

Neither Mann nor Cummings teach or suggest the features in these dependent claims as claimed by the Appellant in combination with corresponding independent claims.

The Applicant traverses these assertions because the none of these practices were well known at the time the Appellant's application was filed in 2001. In addition, none of these practices were obvious when fully considered with all of the limitations of the corresponding independent claims as described above and at the time the Appellant's application was filed. In addition, the Examiner again improperly rejects the Appellant's claims over the Appellant's own application and alleged AAPA, which there is none.

The Appellant has also made arguments with respect to Independent claims 1, 14, 19, 25, 30 and 32. See previous pages. Thus, the Appellant has specifically pointed out the error's in the Examiner's assertions. The Appellant also requests the Board instruct the Examiner to provide proof from the prior art, and not from the Appellant's own application proofing these features were well known under 37 C.F.R. 1.104(c)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

If an independent claim is non-obvious under 35 USC 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988). These dependent claims add additional limitations not present the independent claims. The Appellant has clearly pointed out why the independent claims not obvious. Thus, the dependent claims are not obvious either under the holding of *In re Fine* and their rejections must be immediately withdrawn.



**CONCLUSION FOR ISSUE 4**

Therefore, the Appellant now requests the Appeal Board instruct the Examiner to immediately withdraw the §103(a) rejections with respect to the cited claims.

Since none of these claims are not obvious they should be immediately allowable in their present form.

**ARGUMENT for ISSUE 5**

The Appellant traverses the Examiner's rejection. All of the arguments for Issues 1 and 2 discussed above are incorporated herein by reference.

As was discussed in detail above, the Appellant did not admit any of the claim elements of the claimed invention in the Background section of the application. All the Appellant did was provide a general background discussion. There is no AAPA that describes the claimed invention. Period. Enough said. As a result, the 103 rejection is improper on its face since Koritzinsky does not teach, suggest or even mention domain names. Thus, the Examiner has clearly not provided a prima facie basis for obviousness under 35 U.S.C. §103(a).

Thus, the Appellant really need not respond any further. However, the Appellant responds as follows to point out all the remaining errors in the Examiner's assertions for the Board.

The Board is asked to turn to Appendix B and review the Appellant's response to these references in Appellant's First Response and Second Response.

Burnstein does not teach or suggest the features in these dependent claims as claimed by the Appellant in combination with corresponding independent claims.

The Applicant traverses these assertions because none of these practices were well known at the time the Appellant's application was filed in 2001. In addition, none of these practices were obvious when fully considered with all of the limitations of the corresponding independent claims as described above and at the time the Appellant's application was filed. In addition, the Examiner again improperly rejects the Appellant's claims over the Appellant's own application and alleged AAPA, which there is none.

The Appellant has also made arguments with respect to Independent claims 1, 14, 19, 25, 30 and 32. See previous pages. Thus, the Appellant has specifically pointed out the error's in the Examiner's assertions. The Appellant also requests the Board instruct the Examiner to provide proof from the prior art, and not from the Appellant's own application proofing these features were well known under 37 C.F.R. 1.104(c)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

If an independent claim is non-obvious under 35 USC 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988). These dependent claims add additional limitations not present the independent claims. The Appellant has clearly pointed out why the independent claims not obvious. Thus, the dependent claims are not obvious either under the holding of *In re Fine* and their rejections must be immediately withdrawn.

#### **CONCLUSION FOR ISSUE 5**

Therefore, the Appellant now requests the Appeal Board instruct the Examiner to immediately withdraw the §103(a) rejections with respect to the cited claims. Since none of these claims are not obvious they should be immediately allowable in their present form.

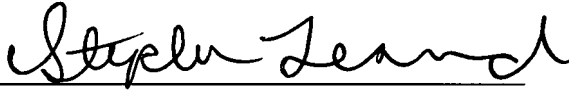
**CONCLUSION FOR ALL ISSUES**

For the foregoing reasons, Appellant submits that all of the Examiner's rejection of claims 1-33 are clearly erroneous. Accordingly, Appellant respectfully requests that the Appeal Board reverse all of the the Examiner's rejection of claims 1-33 and immediately pass all claims 1-33 to allowance.

Respectively submitted:

Lesavich High-Tech Law Group, P.C.

Date: August 28, 2007

By:   
Stephen Lesavich, PhD  
Registration No. 43,749

## **APPENDIX A – Claims Listing Appendix**

### **Claims 1-33:**

1. **(Original)** A method for protecting domain name registrations with a permanent registration certificate, comprising:

accepting information associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system;

accepting a one-time permanent registration fee for the domain name registration on the permanent domain name registration system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration; and

issuing a permanent registration certificate for the domain name registration based on the accepted information, wherein the permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system.

2. **(Original)** The method of Claim 1 further comprising a computer readable medium having stored therein instructions for causing a processor to execute the steps of the method.

3. **(Original)** The method of Claim 1 further comprising:  
  
creating an electronic permanent registration certificate from the accepted information; and  
  
storing an electronic permanent registration certificate in one or more databases associated with the permanent domain name registration system, wherein the stored electronic permanent registration certificate can be viewed via a computer network.

4. **(Original)** The method of Claim 1 further comprising:  
  
issuing a domain name registration insurance policy with the permanent registration certificate, wherein the insurance policy covers financial losses associated with not properly renewing a domain name registration.

5. **(Original)** The method of Claim 1 further comprising:  
  
issuing a domain name registration title with the permanent registration certificate, wherein the domain name registration title covers financial losses associated with not properly renewing a domain name registration.

6. **(Original)** The method of Claim 1 further comprising:  
  
issuing a plurality shares in the domain name associated with the permanent registration certificate, wherein, the plurality of shares allow a plurality of ownership interests to be sold in the domain name registration associated with the permanent registration certificate.

7. **(Original)** The method of Claim 1 further comprising:

issuing leases or sub-leases for the domain name associated with the permanent registration certificate, wherein, the leases or sub-leases allow ownership interests to be reserved for a limited duration in the domain name registration associated with the permanent registration certificate.

8. **(Original)** The method of Claim 1 further comprising:

issuing co-ownership certificates for the domain name associated with the permanent registration certificate, wherein, co-ownership certificates allow two or more entities in two or more different locations to co-own one domain name registration associated with the permanent registration certificate.

9. **(Original)** The method of Claim 1 wherein the step of issuing a

permanent registration certificate includes issuing an electronic permanent registration certificate or other than an electronic permanent registration certificate.

10. **(Original)** The method of Claim 1 wherein the one-time permanent

registration fee is added to a financial instrument whose profits or interest is used to perpetually pay future renewal fees for the domain name registration.

11. **(Original)** The method of Claim 10 wherein the financial instrument

includes an interest bearing account, a certificate of deposit, mutual funds, stocks, bonds or annuities.

12. **(Original)** The method of Claim 1 wherein the step of accepting a one-time permanent registration fee includes accepting a one-time permanent registration fee electronically over the Internet.

13. **(Original)** The method of Claim 1 wherein the step of accepting a one-time permanent registration fee includes accepting a one-time permanent registration fee other than electronically over the Internet.

14. **(Original)** A method for providing permanent registration of domain names, comprising:

(a) generating a list of domain name registrations from one or more databases associated with a permanent domain name registration system for which renewal fees on a public domain name registrar must be paid, wherein the generated list of domain name registrations includes a plurality of domain name registrations for which a plurality of permanent registration certificate has been purchased,

wherein the permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees for the domain name registration at the public domain name registrar from the permanent domain name registration system;

(b) paying renewals fees electronically on the public domain name registrar for the list of generated domain name registrations;



(c) querying the public domain register to determine whether all of the domain name registrations from the generated list of domain name registrations have been renewed on the public domain name registrar, and if not,

(d) transferring additional renewal fees for any domain name registrations from the generated first list of domain name registrations that have not been renewed on the public domain name registrar, thereby ensuring renewal of domain name registrations, and

(e) notifying administrators at the permanent domain name registration system and the public domain name registrar of any renewal fee discrepancies; and

(f) repeating steps (a)-(c) periodically.

15. **(Original)** The method of Claim 14 further comprising a computer readable medium having stored therein instructions for causing a processor to execute the steps of the method.

16. **(Original)** he method of Claim 14 wherein the step of generating a list of domain name registrations includes generating a list of domain name registrations a pre-determined time period before renewal fees on a public domain name registrar must be paid.

17. **(Original)** The method of Claim 14 further comprising:  
periodically comparing renewal dates for the plurality of domain name registrations on the permanent domain name registration system with the renewal dates on the public domain name registrar; and  
notifying administrators at the permanent domain name registration system and the public domain name registrar of any renewal date discrepancies.

18. **(Original)** The method of Claim 14 further comprising:  
periodically comparing renewal dates for the plurality of domain name registrations on the permanent domain name registration system with the renewal dates on the public domain name registrar;  
determining from the permanent domain name registration system whether any renewal fees are due for any domain name registrations for which the public domain name registrar does not show a renewal fee is due, and if so,  
transferring additional renewal fees for any such domain name registrations, and notifying administrators at the permanent domain name registration system and the public domain name registrar of any renewal date discrepancies.

19. **(Original)** A method for providing a permanent web-site, comprising:

accepting a domain name for which a permanent registration certificate has been issued, wherein the permanent registration certificate provides a permanent registration of the domain name including perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar from a permanent domain name registration system;

accepting electronic content for a permanent web-site to be associated with the domain name on the permanent domain name registration system;

accepting a one-time permanent web-site fee for hosting the domain name on the permanent domain name registration system, wherein the one-time permanent web-site fee is used to perpetually host the domain name on the permanent domain name registration system; and

perpetually hosting a permanent web-site accessible via the Internet for the domain name for which a permanent registration certificate has been issued.

20. **(Original)** The method of Claim 19 further comprising a computer readable medium having stored therein instructions for causing a processor to execute the steps of the method.

21. **(Original)** The method of Claim 19 wherein the one-time permanent web-site fee is added to a financial instrument whose profits or interest is used to perpetually pay administrative costs to host a web-site for the domain name accessible via the Internet on the permanent domain name system.

22. **(Original)** The method of Claim 21 wherein the financial instrument includes an interest bearing account, a certificate of deposit, mutual funds, stocks, bonds or annuities.

23. **(Original)** The method of Claim 19 wherein the step of perpetually hosting a web-site includes perpetually hosting the web-site on the permanent domain name registration system.

24. **(Original)** The method of Claim 19 wherein the step of perpetually hosting a web-site includes perpetually hosting the web-site on a host other than the permanent domain name registration system.

25. **(Original)** A method of providing co-use of a permanent registration of a domain name, comprising:

hosting a permanent domain name on a network server, wherein the permanent domain name is a domain name for which a permanent registration certificate has been issued, wherein the permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at a public domain name registrar from a permanent domain name registration system and wherein the permanent domain name is co-used by a plurality of co-users;

accepting a request for electronic content on the network server for one of the plurality of co-users using the permanent domain name;

determining which one of the plurality of co-users the request is for using information included in headers used with a protocol used to request the electronic content; and

directing the request to the determined co-user.

26. **(Original)** The method of Claim 25 further comprising a computer readable medium having stored therein instructions for causing a processor to execute the steps of the method.

27. **(Original)** The method of Claim 25 wherein the plurality of co-users are co-owners of the permanent domain name.

28. **(Original)** The method of Claim 25 wherein the plurality of co-users are leasing or sub-leasing the permanent domain name.

29. **(Original)** The method of Claim 25 wherein the step determining which one of the plurality of co-users the request is for using information included in headers used with a protocol used to request the electronic content includes determining which one of the plurality of co-users the request is for using an Internet Protocol address included in a header used with a protocol used to request the electronic content.

30. **(Original)** A permanent domain name registration system, comprising in combination:

a permanent registration certificate for providing permanent registration of a domain name, wherein the permanent registration certificate provides a permanent registration of a domain name including perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar; and

a plurality of servers associated with a plurality of databases accessible via the Internet for accepting information associated with a domain name registration obtained at the public domain name registrar, accepting a one-time permanent registration fee for the permanent registration certificate and for issuing the permanent registration certificate.

31. **(Original)** The system of Claim 30 wherein the plurality of servers associated with a plurality of databases include a Purchase/Payment server and associated database, an administrative server and associated database and a permanent web-site server and associated database.

32. **(Original)** A permanent domain name registration system, comprising in combination:

a permanent registration certificate for providing permanent registration of a domain name, wherein the permanent registration certificate provides a permanent registration of a domain name including perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar;

a permanent web-site for perpetually hosting a web-site associated with the domain name registration from an issued permanent registration certificate, wherein the web-site is accessible via the Internet; and  
a plurality of servers associated with a plurality of databases accessible via the Internet for issuing a permanent registration certificate for a domain name registration, perpetually hosting a web-site associated with the domain name registration from an issued permanent registration certificate, wherein the web-site is accessible via the Internet, accepting a one-time permanent registration fee for the permanent registration certificate and accepting a one-time permanent web-site fee for perpetually hosting a web-site associated with the domain name registration from an issued permanent registration certificate.

33. **(Original)** The system of Claim 32 wherein the plurality of servers associated with a plurality of databases include a Purchase/Payment server and associated database, an administrative server and associated database and a permanent web-site server and associated database.

**APPENDIX B – Evidence Appendix**

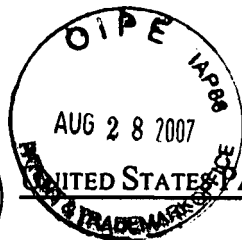
The Appellant has cited various sections of the following documents included as Exhibits A-F via this Evidence Appendix in the arguments in the preceding pages. All of these documents are part of the public record for the patent application either received from or sent to the USPTO, or published by the USPTO.

1. **First Office Action – Exhibit A**
2. **First Appellant Response – Exhibit B**
3. **Second Office Action – Exhibit C**
4. **Second Appellant Response – Exhibit D**
5. **Third Final Office Action – Exhibit – E**
6. **Published Patent Application 20020010795 – Exhibit F**



**APPENDIX C – Related Proceedings Appendix**

*Not Applicable.*



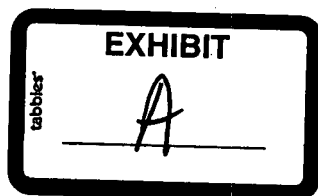
UNITED STATES PATENT AND TRADEMARK OFFICE

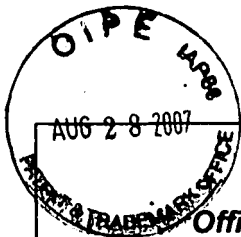
UNITED STATES DEPARTMENT OF COMMERCE  
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,408	06/07/2001	Charles P. Brown	00,464-A	7316
32097	7590	12/05/2005	EXAMINER	
LESAVICH HIGH-TECH LAW GROUP, P.C. SUITE 325 39 S. LASALLE STREET CHICAGO, IL 60603			NGUYEN, NGHIA D	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.





## Office Action Summary

Application No.	Applicant(s)	
09/876,408	BROWN, CHARLES P.	
Examiner	Art Unit	
Patrick D. Nguyen	3629	

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
Period for Reply

### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/58/08)  
Paper No(s)/Mail Date 12/22/04, 12/23/04, 3/09/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The U.S department of commerce, working under the authority of the Congress, is under contract with ICANN for the domain name registration, and therefore has no authority to grant a patent to a system that they have no jurisdiction over. In the memorandum of Understanding between Dept of Commerce and ICANN it states that ICANN business purpose is

- i) coordinate the assignment of Internet technical parameters as needed to maintain universal connectivity on the Internet
- ii) perform and oversee functions related to the coordination of the Internet Protocol (IP) address space
- iii) perform and oversee functions related to the coordination of the Internet domain name system including the development of policies for determining the circumstances under which new top level domains names are added to the DNS root system.

Claim 1-33 are rejected on ground that they infringe on U.S laws set forth by Congress.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 1-13 and 19-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Prior Art (or APPA) or Mann et al (U.S. patent No. 6,519, 589) in view of KORITZINSKY et al (U.S. patent No.6272469) in view of Hagan (U.S. patent No.6415267)

As for claim 1, AAPA fairly disclose the method of registration is well known .  
Accepting information from a public domain name registrar is necessary for any domain name registration system. Also, Mann et al teaches a method of obtaining information (plurality of names) from a public domain name registrar database for domain name registration (See Abstract). Mann discloses the invention except for :

Method of payment the fee or payment for service used (in this case, registration of domain name) i.e. accepting a one-time registration payment fee that can be used to perpetually pay for all future renewal fees for domain name registration instead of paying annually or pay-per-use.

KORITZINSKY et al is cited to teach the general concept of paying for a subscribed service such as (a) pay per use, (b) annually (c) periodically, or (d) permanently for the benefit of lifetime service or non-expiring warranty service with one-time payment of fee (one-time fee service) {see column 21, lines 16-31, col.22 lines 50-58}. It would have been obvious to modify the fee payment process of Mann et al by using option (d) or one-time payment of fee(one time fee service) as taught by KORITZINSKY et al for the benefit cited above, which is lifetime service or non-expiring warranty services. As for the limitation of "a permanent registration certificate", Mann et al would normally issue a registration certificate based on the type of payment of fee, and since this is in combination of KORITZINSKY et al , the issuance of a permanent registration certificate is inherently included or would have been obvious to a skilled artisan to do so if desired.

As for Claim 2, a computer medium (i.e. ram or any storage device ) is inherently needed to store registration instruction.

As for Claim 3, a permanent registration certificate is inherently needed for receipt or proof of registration & purchase if a permanent registration took place and reference to claim 2, its inherent the information need a place to be store (i.e. database)

As for Claim 4, KORITZINSKY et al teaches a lifetime subscription warranty on the registration certificate (Column 21, paragraph 2, line 20). Warranty is an insurance that cover financial losses with not properly renewing.

As for Claim 5, issuing title to show a lifetime service/ ownership is a well know and concept, and it would be obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 6, issuing a plurality of shares is a well-known concept, corporation can sell shares to public to own, and invest in their company. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 7, issuing leases or subleases is a well known concept (i.e. house leasing, car leasing, anything can be leases, including domain names at sites like <http://allfordomains.com/rent.asp/>) It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 8, it is well known that you can have co-ownership of a property (joint-title, joint tenant ownership). It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 9, issuing an email certificate is well-known and obvious routine for online registration procedure. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 10, KORITZINSKY et al failed to teaches using the permanent registration fee to be added to a financial instrument whose profit can be use to perpetually pay for future renewal fees. However, Hagan (U.S. Pat 6415267) discloses investing in a financial instrument (Abstract line 6) whose profit can be release to pay contractually defining events (Abstract line 22) Motivation to combine KORITZINSKY et al and Hagan is to generate income to perpetually pay for future renewal cost. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.



As for Claim 11, Hagan discloses investing in a financial program to generate fund (i.e. interest bearing accounts, mutual funds, stocks, bonds). It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 12, KORITZINSKY et al disclose accepting a one-time permanent registration fee. It is well known and obvious that an electronic fee is necessary since registration is taking place over the Internet. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 13, if registration fee doesn't take place over the Internet than it would be obvious to use U.S postal mail.

Claims 14-18 are rejected under 35 U.S.C 103(a) as being unpatentable over Schneider (U.S. patent No.6901, 436) in view of KORITZINSKY et al.

As for claim 14, Schneider teaches a method, product, and apparatus for requesting a network resource (see Abstract, line 1-7), in which he teaches displaying query results for the plurality of domain names register in the domain registration system. Schneider teaching does not include: determine the renewal fee, paying the renewal fee, transferring additional renewal fee to maintain the right of the domain name. However, KORITZINSKY et al (Abstract, line 1-8) teaches a method of determining, paying and verifying current and future renewal fee for registration subscription. (Column 23, line 5-15) Motivation to combine the teaching of Schneider with KORITZINSKY et al is to have automatic renewal system for domain name.

As for Claim 15, a computer medium (i.e. ram or any storage device) is inherently needed to store registration instruction.

As for Claim 16-18, KORITZINSKY et al teaches a method of renewal registration subscription including generating a listing of current registration holder (Column 19, line 10) and notifying personnel or renewal information (Column 24 line, 24-25)

Claim 19-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Prior Art (or APPA) or Mann et al (U.S. patent No. 6,519, 589) in view of KORITZINSKY et al (U.S. patent No.6272469) in view of Hagan (U.S. patent No.6415267).

As for claim 19, 20, 23, 24. AAPA in view of KORITZINSKY et al disclose of method of Claim 1. Furthermore its obvious that any domain name registration system needs a web host to host the system and this web host have access to database to store instruction.

As for Claim 21 & 22, KORITZINSKY et al failed to teaches using the permanent registration fee to be added to a financial instrument whose profit can be use to perpetually pay for future renewal fees. However, Hagan (U.S. Pat 6415267) discloses investing in a financial instrument (Abstract line 6) whose profit can be release to pay contractually defining events (Abstract line 22) Motivation to combine KORITZINSKY et al and Hagan is to generate income to perpetually pay for future renewal cost. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for claim 25, AAPA in view of KORITZINSKY et al disclose of method of Claim 1. Furthermore its obvious that any domain name registration system needs a web host to host the system and this web host have access to database to store instruction over a server because the nature of the system is dependent on being "online" . It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for claim 26, it obvious that a online registration system would need a computer medium, database, and connect over a server to work. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for claim 27, it is well known that you can have co-ownership of a property (joint-title, joint tenant ownership). It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for claim 28, issuing leases or subleases is a well known concept (i.e. house leasing, car leasing, anything can be leases, including domain names at sites like <http://allfordomains.com/rent.asp/>) It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for claim 29, Furthermore co-use of a permanent registration of a domain name is obvious. A domain name for corporation (i.e. I.B.M) is used by many individual. Claim 29 refers to subdomain or secondary URL, in requesting for protocol address, a well-known concept. (i.e. [www.permanent.com/john](http://www.permanent.com/john) , [www.permanent.com/bob/](http://www.permanent.com/bob/) )

As for Claim 30-34, KORITZINSKY et al failed to teaches using the permanent registration fee to be added to a financial instrument whose profit can be use to perpetually pay for future renewal fees. However, Hagan (U.S. Pat 6415267) discloses investing in a financial instrument (Abstract line 6) whose profit can be release to pay contractually defining events (Abstract line 22) Motivation to combine KORITZINSKY et al and Hagan is to generate income to perpetually pay for future renewal cost. It would have been obvious to implant these component into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service benefit/guarantee as taught by KORITZINSKY et al and in further view of Hagan. It is obvious that a online registration system would need a computer medium, database, and connect over a server to work. It would have been obvious to implant these component into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

All Claims are rejected

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Nguyen whose telephone number is 7038395713. The examiner can normally be reached on 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is to 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

W  
nn

  
JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600



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LESAVICH LAW GROUP

PAGE 03/21

Response to Office Action Mailed December 5, 2005  
Patent 09/876,408

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(LHTLG No. 00,464-A)

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JUN 05 2006

In re Application of:

Brown

Serial No. 09/876,408

Filed: June 7, 2001

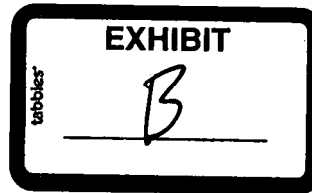
For: METHOD AND SYSTEM FOR  
PROTECTING DOMAIN  
NAMES

Examiner: Nguyen, Nghia D.

Group Art Unit: 3629

Confirmation No. 7316

MAIL STOP:  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA. 22313-1450



**RESPONSE TO OFFICE ACTION**

**MAILED December 5, 2005**

Responsive to the First Office Action mailed December 5, 2005, Applicant  
submits the following Response.

**RESPONSE**

**Remarks**

Claims 1-34 are pending in the Application. Claims 1, 10, 16 and 20 are in  
independent format. Applicant now responds to the Examiner's assertions.

The Applicant asks the Examiner carefully consider the comments below  
with an open mind. If the Examiner carefully and realistically considers the  
comments below with an open mind the Examiner will see that the rejections are

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LESAVICH HIGH-TECH  
LAW GROUP, P.C.  
SUITE 323  
30 SOUTH LA SALLE STREET  
CHICAGO, ILLINOIS 60603  
TELEPHONE (312) 322-3751

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improper, violate the holdings of many different court decisions and cannot be maintained.

**Section §101 Rejection**

The Examiner asserts that "claims 1-33 are rejected on the ground that they infringe on U.S. laws set forth by Congress. The U.S. department of commerce, working under the authority of Congress, is under contract with ICANN for the domain name registration system that they may have no jurisdiction over." The Applicant traverses all of the Examiner's assertions.

**Section 101 Response**

First, the United States Patent and Trademark Office (USPTO) has issued seven patents that include the terms "domain name registration" in the claims. See Table 1 below created by the searching the USPTO web site at [www.uspto.gov](http://www.uspto.gov) on June 5, 2006. In addition, there are 25 published patent applications what include the terms "domain name registration" in their claims.

1	7,039,697	Registry-integrated internet domain name acquisition system
2	7,020,602	Native language domain name registration and usage
3	6,980,990	Internet domain name registration system
4	6,895,430	Method and apparatus for integrating resolution services, registration services, and search services
5	6,760,746	Method, product, and apparatus for processing a data request
6	6,678,717	Method, product, and apparatus for requesting a network resource
7	6,167,449	System and method for identifying and locating services on multiple heterogeneous networks using a query by type

Table 1.

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LESAVICH HIGH-TECH  
LAW GROUP, P.C.  
SUITE 323  
39 SOUTH LA SALLE STREET  
CHICAGO, ILLINOIS 60603  
TELEPHONE (312) 222-3751



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Table 2 includes an additional 13 issued patent that include the terms "domain name registry" in the claims.

1	7,039,697	Registry-integrated internet domain name acquisition system
2	7,003,661	Methods and systems for automated authentication, processing and issuance of digital certificates
3	7,000,028	Automated domain name registration
4	6,980,990	Internet domain name registration system
5	6,854,074	Method of remotely monitoring an internet web site
6	6,842,770	Method and system for seamlessly accessing remotely stored files
7	6,839,769	Method for establishing secure communication link between computers of virtual private network without user entering any cryptographic information
8	6,826,616	Method for establishing secure communication link between computers of virtual private network
9	6,735,585	Method for search engine generating supplemented search not included in conventional search result identifying entity data related to portion of located web page
10	6,687,733	Method and system for automatically configuring a client-server network
11	6,519,859	System and method for generating domain names and for facilitating registration and transfer of the same
12	6,654,813	Dynamically categorizing entity information
13	6,018,761	System for adding to electronic mail messages information obtained from sources external to the electronic mail transport process

Table 2.

These patents issued to individuals and organizations, as far as the Applicant can tell, are not related to ICANN. If the USPTO has no authority to grant a patent including domain name registrations or registries, how did the USPTO grant such patents already? Patent 7,039, 697 entitled "Registry-integrated internet domain name acquisition system," was granted on May 2, 2006. Clearly, this wasn't illegal and the USPTO had the authority to grant such a patent.

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LESAVICH HIGH-TECH  
LAW GROUP, P.C.  
SUITE 320  
39 SOUTH LA SALLE STREET  
CHICAGO, ILLINOIS 60603  
TELEPHONE (312) 332-3761

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If the Examiner is correct, which does not appear to be the case, the USPTO has already violated U.S. laws set forth by Congress by issuing the patents in Tables 1 and Table 2. If the Examiner is incorrect, and that appears to be the case in the matter, the USPTO is not treating all applicant's for patents related to domain names fairly in violation of the patent rules.

Second, the Applicant's invention includes, in general, managing domain name registrations obtained from a public domain name registrar and paying fees back to the public domain name registrar to maintain a permanent domain name registration. This clearly can not and does not infringe on the laws of the United States as set forth by Congress or their contract with ICANN as the public domain name register issues the domain name registrations and is paid for their maintenance.

Third, if the Applicant's invention did violate the laws the United States, why did the Examiner further apply the patent laws of the United States and reject the Applicant's invention under Section 103 of the patent laws? If what the Examiner asserted was true, there would be no need to further apply any additional sections of the patent laws.

Fourth, the Examiner cited the U.S. Patent No. 6,519,589 to Mann et al. against the Applicant which a patent invention including a system for generating a domain name and for facilitating its registration with a public domain name registrar. If the Mann invention does not infringe U.S. law as set forth by Congress how can the Applicant's?

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LESAVICH HIGH-TECH  
LAW GROUP, P.C.  
SUITE 325  
20 SOUTH LA SALLE STREET  
CHICAGO, ILLINOIS 60603  
TELEPHONE (312) 332-3781

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The Examiner has clearly incorrectly applied Section 101. The Applicant requests the Section 101 rejection be immediately withdrawn.

**First Section 103 Rejection**

Claims 1-13 and 19-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann (U.S. Patent No. 6,519,589) in view of Koritzinsky (U.S. Patent No. 6,272,469) in view of Hagan (U.S. Patent No. 6,415,267).

The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

**First Section 103 Response**

The Examiner is reminded that to establish prima facie obviousness of a claimed invention in the first place, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). A prima facie case of obviousness may also be rebutted by showing in the cited art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997).

**Claim 1**

Claim 1 recites "*a method for protecting domain name registrations with a permanent registration certificate, comprising (1) accepting information associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system; (2) accepting a one-time permanent registration fee for the domain name registration on the permanent domain name*

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LESAVICH HIGH-TECH  
LAW GROUP, P.C.  
SUITE 320  
30 SOUTH LASALLE STREET  
CHICAGO, ILLINOIS 60603  
TELEPHONE (312) 332-3751

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*registration system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration; (3) storing the accepted information in one or more databases associated with the permanent domain name registration system; (4) issuing a permanent registration certificate for the domain name registration, wherein the permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system."* (Parenthesized numbers not in original claim added by Applicant in this paper for discussion purposes only).

First, the Examiner asserted that Claim 1 is rejected over "Applicant Admitted Prior Art." However, the Applicant did not file any Information Disclosure Statements (IDS) that included the two patents, Mann, or Koritzinsky as cited by the Examiner as Applicant Admitted Prior Art.

Second with respect to the patent to Hagan, the Applicant filed an IDS including a the Hagan patent. However, the Applicant made no such admissions with respect to Hagan being relevant prior art. The Applicant clearly states in the letters filed with each of the IDSs that *"The references have not been reviewed in sufficient detail to make any other representation and, in particular, no representation is indented as to the relative importance of any portion of the references. This Statement is not a representation that the cited references have effective dates early enough to be 'prior art' within the meaning of 35 U.S.C. sections 102 or 103."*

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LESAVICH HIGH-TECH  
LAW GROUP, P.C.  
SUITE 320  
38 SOUTH LA SALLE STREET  
CHICAGO, ILLINOIS 60603  
TELEPHONE (312) 332-3751

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Third, the Examiner rejected Claim 1 in part in view of Hagan. However the Examiner provided no assertions or commentary for Hagan with respect to Claim 1. Clarification is requested as to the rejections of Claim 1 in view of Hagan.

Next, the Examiner asserts that Mann teaches "a method of obtaining information (plurality of names) from a public domain registrar for domain name registration (See Abstract)." By the Examiner's own words this does not match what is recited by the first element of Claim 1 which recites "*accepting information associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system.*"

In contrast to the Examiner's assertions, Mann actually teaches a "System and method for generating domain names and for facilitating registration and transfer of the same." (Title). This teaches away from what is recited by the first element of Claim 1 which includes obtaining information for a domain name that has been already registered with a public domain name registrar.

Third, Mann further teaches "New and improved systems and methods for generating and facilitating registration and transfer of available domain names. The systems and methods include and involve a data storage facility for storing at least one adjunct term for use in generating at least one registerable domain name, and a processor arrangement which is coupled to the data storage facility and which is configured to be accessed by a user system via an electronic data network, to receive at least one root term from the user system, to concatenate at least one root term with at least one adjunct term to generate at least one candidate domain name, to query a data source to determine if the candidate domain name(s) is available for

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LESAVICH HIGH-TECH  
LAW GROUP, P.C.  
SUITE 220  
30 SOUTH LA SALLE STREET  
CHICAGO, ILLINOIS 60603  
TELEPHONE (312) 322-3751

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registration and/or transfer, and to notify the user system of the candidate domain name(s) when the same are available for registration and/or transfer." (Abstract)

Thus, the Abstract cited by the Examiner includes teachings that not only teach away from the claimed invention but also clearly does not teach or suggest the first element of Applicant's Claim 1.

The Examiner then admits that Mann does not teach or suggest the claim elements two and part of four of Claim 1 of "*accepting a one-time registration payment fee that can be used to perpetually pay for all future renewal fees for domain name registration instead of paying annually or pay-per-use.*"

The Examiner is reminded that to establish *prima facie* obviousness of a claimed invention in the first place, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974).

Since Mann does not teach or suggest element one as discussed above or element two or part of four by the Examiner's own admissions, the Examiner has not established a *prima facie* case of obviousness for the claimed invention in view of Mann in violation of the holdings of *In re Royka*. Thus, Claim 1 is not obvious and the Section 103 rejection should be immediately withdrawn.

The Applicant need not respond any further. However, for completeness the Applicant responds as follows.

The Examiner is reminded that even if a case of *prima facie* obviousness is established, which is not the case in the matter as was described above, a *prima facie* case of obviousness may be rebutted by showing in the cited art, in any

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LESAVICH HIGH-TECH  
LAW GROUP, P.C.  
SUITE 325  
38 SOUTH LA SALLE STREET  
CHICAGO, ILLINOIS 60603  
TELEPHONE (312) 392-5751

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material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997).

Mann clearly teaches away from the claimed invention by requesting root terms, generating domain names using the root terms and determining if the generated domain name is available for registration (Abstract). This clearly teaches away from the Applicant's invention as recited by Claim 1 which has not such limitations.

In addition, Mann clearly teaches "Registration should be interpreted to mean that an available domain name generated in accordance with the present invention may be registered (e.g., such as via a domain name registration authority)." Col. 8, lines 4-6. This clearly teaches away from the Applicant's invention as recited by Claim 1. Thus, if a *prima facie* case of obviousness did somehow exist in view solely of Mann, the Applicant has also rebutted it based on the holding of *In re Geisler*.

The Examiner is also reminded that obviousness can only be established by combining the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992). If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no motivation to make the proposed modification. *In Re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). If a proposed modification or combination of the prior art would change the principle

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LESAVICH HIGH-TECH  
LAW GROUP, P.C.  
SUITE 225  
28 SOUTH LASALLE STREET  
CHICAGO, ILLINOIS 60603  
TELEPHONE (312) 332-3701

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operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti  
270 F.2d 810 (CCPA 1959).

The Examiner then asserts Koritzinsky et al teaches the "general concept of paying for a subscribed service such as (a) pay per use, (b) annually (c) periodically, or (d) permanently for the benefit of lifetime service or non-expiring warranty service with one-time payment of fee (one-time service) (See column 21, lines 16-31, col. 22, lines 50-58). It would have been obvious to modify the fee payment process of Mann by using option (d) or one-time payment of fee (one time fee service) as taught by Koritzinsky for the benefit as cited above, which is lifetime service or non-expiring warranty services."

First, Mann does teach suggest or even mention a payment process for domain names as the Examiner asserts. If the Examiner thinks that Mann teaches a fee payment process the Applicant requests the Examiner specifically state the column and lines in Mann where a fee payment process is taught or suggested.

Second, Koritzinsky teaches "an Imaging system protocol handling method and apparatus" (Title) and "A technique is disclosed for providing programs, such as operational protocols, to medical diagnostic institutions and systems. The protocols are created and stored on machine readable media. A description of the protocols is displayed at the diagnostic institution or system. A user may select a desired protocol or program from a user interface, such as a listing of protocols. The protocol listing may include textual and exemplary image descriptions of the protocols. Selected protocols are transferred from the machine readable media to the

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LESAVICH HIGH-TECH  
LAW GROUP, P.C.  
SUITE 325  
30 SOUTH LASALLE STREET  
CHICAGO, ILLINOIS 60602  
TELEPHONE (312) 333-3751



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diagnostic institution or system. The transfer may take place over a network link, and may be subject to fee arrangements, subscription status verifications, and so forth. Protocols may be loaded for execution on system scanners by selection from the same or a similar protocol listing screen." (Abstract). Thus, Koritzinsky primarily teaches handling protocols of medical imaging services.

Third, Koritzinsky does not teach, suggest or even mention domain names or domain name registrations anywhere, period.

Fourth, combining Mann and Koritzinsky still does not teach or suggest what is recited by the claimed invention. Mann teaches a method for generating domain names and for facilitating registration of the domain names. (Abstract). Koritzinsky teaches an imaging system protocol handling method and apparatus for medical imaging (Title and Abstract). Adding a one-time payment for medical imaging diagnostic services from Koritzinsky to the system and method for generating and facilitating registration of domain names does not teach or suggest what is recited by the claimed invention.

Fifth, there is no motivation to combine Mann with Koritzinsky because because Koritzinsky changes at least one principal operation of Mann and renders Mann unsatisfactory for one of its intended purposes in violation of the holdings of *In re Fine*, *In Re Gordon* and *In re Ratti*.

For example, Mann teaches generating a domain name from a root word obtained from a user, checking the availability of the generated domain name, notifying a user of the availability of a domain name and allowing a user an option

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LESAVICH HIGH-TECH  
LAW GROUP, P.C.  
SUITE 325  
39 SOUTH LA SALLE STREET  
CHICAGO, ILLINOIS 60603  
TELEPHONE (312) 333-3751

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to register an available domain name with a domain name registrar (Abstract, Col. 3, line 40 through Col. 8, line 16 and Claims.).

Mann clearly teaches at Col. 8, lines 4-7, "In the preceding discussion, registration of available domain names has been mentioned as an option related to an available domain name generated in accordance with the present invention... Registration should be interpreted to mean that an available domain name generated in accordance with the present invention may be registered (e.g., such as via a domain name registration authority).

Thus, there is no motivation to combine Mann and Koritzinsky as the Examiner suggests. Even if Mann and Koritzinsky were combined, the combination still does teach or suggest the claimed invention as the Examiner suggests.

The Examiner further asserts that "as for the limitation of a permanent registration certificate, Mann would normally issue a registration certificate based on the type of payment of fee."

This is an incorrect statement based on the teachings of Mann. As was discussed above Mann clearly teaches "Registration should be interpreted to mean that an available domain name generated in accordance with the present invention may be registered (e.g., such as via a domain name registration authority)." Col. 8, lines 4-6. This it is the domain name authority and not Mann that issues the domain name registration certificate.

Finally, the Examiner asserts that "the issuance of a permanent registration certificate is inherent included in combination with Koritzinsky." This is again an incorrect statement since Mann does not issue domain name registration

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LESAVICH HIGH-TECH  
LAW GROUP, P.C.  
SUITE 325  
28 SOUTH LASALLE STREET  
CHICAGO, ILLINOIS 60606  
TELEPHONE (312) 322-3751

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certificates, the domain name registration authority does so Mann does not explicitly or inherently teach issuing a domain name registration certificate. In addition, Koritzinsky does not explicitly or inherently teach or suggest a permanent domain name registration certificates because Koritzinsky does not teach or suggest or even mention domain names.

Thus, there is no motivation to combine Mann and Koritzinsky. Trying to do so violates the holdings of *In re Fine*, *In Re Gordon* and *In re Ratti*.

The Applicant has clearly shown why Claim 1 is not obvious over Mann in view of Koritzinsky. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claim 1. Since this claim is not obvious it should be immediately allowable in its present form.

**Claims 2-9**

The Examiner is reminded that if an independent claim is non-obvious under 35 USC 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988).

All of arguments for Claim 1 are incorporated by reference. Claims 2-9 add additional limitations not present in Claim 1.

The Applicant has clearly pointed out why Independent Claim 1 is not obvious. Thus, Claims 2-9 are not obvious under the holding of *In re Fine*.

In addition, Applicant responds to the Examiner's assertion that the additional limitations described in Claims 2-9 are inherent.

The Examiner is reminded that to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the

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LESAVICH HIGH-TECH  
LAW GROUP, P.C.  
SUITE 325  
39 SOUTH LA SALLE STREET  
CHICAGO, ILLINOIS 60603  
TELEPHONE (312) 232-3751

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thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

The Examiner clearly has not met the burden of proof for inherency under *In re Robertson*. No person skilled in the art, when viewing the teachings of Koritzinsky that teaches providing medical imaging system protocols for medical imaging system services and does not teach, suggest or even mention domain names, would inherently find a permanent domain name registration certificate, a lifetime subscription warranty, plural shares in the permanent domain name registration, a lease on the permanent domain name registration, co-ownership on the permanent domain name registration or any of the other additional limitations described by Claims 2-9.

In addition, the Applicant traverses all of the Examiners assertions of concepts described by the limitations in Claims 2-9 as being well known. The Examiner's assertions include several errors with respect to Claims 2-9. None of the concepts the Examiner described as well known had ever been associated with permanent domain name registrations. In fact most of the statements the Examiner asserted as well known are not even well known with respect to the Internet. And certainly not well known with respect to use with domain names or permanent domain name registrations.

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LESVICH HIGH-TECH  
LAW GROUP, P.C.  
SUITE 325  
28 SOUTH LA SALLE STREET  
CHICAGO, ILLINOIS 60603  
TELEPHONE (312) 323-3781

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Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 2-9. Since these claims are not obvious they should all be immediately allowable in there present form.

**Claims 19-34**

All of arguments for Claim 1 are incorporated by reference. Claims 19-34 include similar claim limitations related to permanent domain name registrations as are recited by Claim 1.

The Applicant has clearly pointed out why Independent Claims 1 is are not obvious. Thus, Claims 19-34 are not obvious by the same arguments outlined for Claim 1.

Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 19-34. Since these claims are not obvious they should all be immediately allowable in there present form.

**Second Section 103 Rejection**

Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mann (U.S. Patent No. 6,519,589) in view of Koritzinsky (U.S. Patent No. 6,272,469) in view of Hagan (U.S. Patent No. 6,415,267).

The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

**Second Section 103 Response**

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LESAVICH HIGH-TECH  
LAW GROUP, P.C.  
SUITE 320  
38 SOUTH LA SALLE STREET  
CHICAGO, ILLINOIS 60603  
TELEPHONE (312) 332-3751

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**Claim 10**

The Applicant accepts the Examiner's admission that Koritzinsky "failed to teach using the permanent registration fee to be added to a financial instrument whose profit can be used to perpetually pay future renewal fees."

The Examiner further asserts, Hagan discloses investing in a financial instrument (Abstract line 6) whose profit can be release to pay by contractually defining events (Abstract line 22). Motivation to combine Koritzinsky and Hagan is to generate income to peretually pay for future renewal cost. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann and in further view of lifetime/service/benefit/guarantee as taught by Koritzinsky."

All of the arguments for Claim 1 above are incorporated by reference for Claim 10 and further apply in view of Hagan. The combination of these three references still does not teach or suggest the claimed invention claimed by Claim 10.

Thus, Claims 10 is not obvious. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 10 in view of Hagan. Since this claims is not obvious it should all be immediately allowable in its present form.

**Third Section 103 Rejection**

Claims 14-18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider (U.S. Patent No. 6,901, 436 in view of Koritzinsky (U.S. Patent No. 6,272,469).

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LESAVICH HIGH-TECH  
LAW GROUP, P.C.  
SUITE 925  
33 SOUTH LA SALLE STREET  
CHICAGO, ILLINOIS 60603  
TELEPHONE (312) 332-3701

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The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

### Third Section 103 Response

#### Claims 14-18

The Applicant accepts the Examiner's admission that Schneider does not teach "*determining a renewal fee, paying a renewal fee, transferring additional renewal fee payments to maintain the right of the domain name.*"

Neither Schneider nor Koritzinsky teach, suggest or even mention permanent domain names or permanent domain name registrations claimed by the Applicant.

All of the arguments for Claims 1 and 10 above are incorporated by reference in view of Schneider. The combination of these three references still does not teach or suggest the claimed invention.

Thus, Claims 14-18 is not obvious. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 14-18 in view of Schneider. Since this claims is not obvious it should all be immediately allowable in their present form.

### Fourth Section 103 Rejection

Claims 19-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann (U.S. Patent No. 6,519,589) in view of Koritzinsky (U.S. Patent No. 6,272,469) in view of Hagan (U.S. Patent No. 6,415,267).

The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the

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LESAVICH HIGH-TECH  
LAW FIRM, P.C.  
SUITE 225  
38 SOUTH LA SALLE STREET  
CHICAGO, ILLINOIS 60603  
TELEPHONE (312) 332-3761

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Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

**Fourth Section 103 Response**

**Claims 19-34**

Applicants accepts all of the Examiner's *admissions* with respect to Claims 21, 22, and 30-34.

All of the arguments for Claims 1 and 10 above are incorporated by reference. The combination of these three references still does not teach or suggest the claimed invention.

The Examiner is reminded that to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*.

The Examiner clearly has not met the burden of proof for inherency under *In re Robertson*. No person skilled in the art, when viewing the teachings of Koritzinsky that teaches providing medical imaging system protocols for medical imaging system services and does not teach, suggest or even mention domain names, would inherently find a permanent domain name registration certificate, a lifetime subscription warranty, plural shares in the permanent domain name registration, a lease on the permanent domain name registration, co-ownership on the permanent domain name registration or any of the other additional limitations described by the claims.

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LESAVICH HIGH-TECH  
LAW GROUP, P.C.  
SUITE 225  
311 SOUTH LA SALLE STREET  
CHICAGO, ILLINOIS 60603  
TELEPHONE: (312) 322-3751



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In addition, the Applicant traverses all of the Examiners assertions of concepts described by the limitations in these as being well known. The Examiner's assertions include several errors with respect to claims. None of the concepts the Examiner described as well known had ever been associated with permanent domain name registrations. In fact most of the statements the Examiner asserted as well know are not even well know with respect to the Internet.

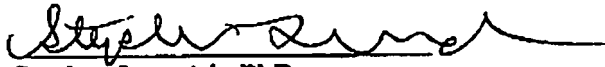
Thus, Claims 19-34 are not obvious. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 19-34. Since this claims is not obvious it should all be immediately allowable in their present form.

**CONCLUSION**

The prior art made of record in the Office Action but not relied upon by the Examiner is no more pertinent to Applicant's invention than the cited references for the reasons given above. The Applicant therefore submits that all of the claims in their present form are immediately allowable and requests the Examiner withdraw the §101 and §103 rejections of claims 1-34 and pass all of the claims immediately to allowance.

Respectfully submitted.

Lesavich High-Tech Law Group, PC (32097)



Stephen Lesavich, PhD

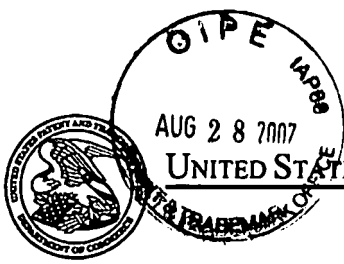
Reg. No. 43,749

Dated: June 5, 2006

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- 19 of 19 -

LESAVICH HIGH-TECH  
LAW GROUP, P.C.  
SUITE 310  
33 SOUTH LA SALLE STREET  
CHICAGO, ILLINOIS 60603  
TELEPHONE (312) 332-2751



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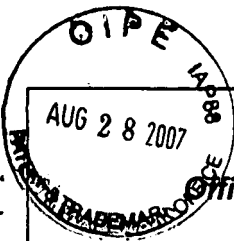
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,408	06/07/2001	Charles P. Brown	00,464-A	7316
32097	7590	08/25/2006	EXAMINER	
LESAVICH HIGH-TECH LAW GROUP, P.C. SUITE 325 39 S. LASALLE STREET CHICAGO, IL 60603			NGUYEN, TAN D	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.





### Office Action Summary

Application No.	Applicant(s)	
09/876,408	BROWN, CHARLES P.	
Examiner	Art Unit	
Tan Dean D. Nguyen	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-33 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see pages 2-4, filed 6/5/06, with respect to the 101 rejections have been fully considered and are persuasive. The rejections of claims 1-33 under 101 rejections are withdrawn.

### ***Claim Rejections - 35 USC § 112***

2. Claims 1-13, 19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 5, the 2<sup>nd</sup> step of "accepting a one-time permanent registration fee" is vague and indefinite. From the specification, it appears this phrase appears to mean "accepting a one-time permanent registration fee payment" and therefore, insertion of the term "payment" after "fee" is recommended to improve clarity.

Similarly, claims 19-24, are rejected for the same reasons set forth in claims 1-13 above.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 1-3, 9, 12-13, 14-18, 19-20, 23-24, 25-29, 30-31, 32-33, which are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of KORITZINSKY et al.**

**Claim 1 is as followed:**

1. A method for protecting domain name registrations with a permanent registration certificate, comprising:

accepting information associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system;

accepting a one-time permanent registration fee for the domain name registration on the permanent domain name registration system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration; and

issuing a permanent registration certificate for the domain name registration based on the accepted information, wherein the permanent registration certificate provides a

permanent registration the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system.

Claim 1 reads over:

A method for protecting a subscription service with a permanent service certificate wherein the service is domain name registrations subscription, comprising:

accepting information associated with a subscription service, wherein the subscription service is domain name registration obtained from a public domain name registrar on a domain name registration system;

accepting a one-time permanent registration fee for the subscription service wherein the subscription service is domain name registration, on a permanent subscription service system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the subscription service; and

issuing a permanent service certificate based on the accepted information, wherein the subscription service is domain name registration, and the permanent service certificate is about domain name registration and the certificate provides a permanent registration the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system.

As shown under the "Background of the Invention" in the specification, the domain name registration basically is subscription service that identifies and protect the IP addresses to make it easier for people to identify the sites on the Internet. Every year, each subscriber has to pay \$35.00/year for the maintaining of the service {see page 4, last paragraph}.

Similarly, as indicated in the specification, under "Background of the Invention", **AAPA** fairly discloses a method for domain name registrations service with a annual registration receipt (certificate), comprising:

(a) accepting information associated with a domain name registration (subscription service) obtained from a public domain name registrar on a domain name registration system {see page 3, last two paragraphs};

(b) accepting a yearly (annual) payment of registration fee for the domain name registration (subscription service) on the annual domain name registration system {see page 4, last paragraph}; and

(b) issuing an annual registration certificate (receipt) for the domain name registration based on the accepted information {see pages 4-6, see "a domain name can registered electronically at nsi.com" on page 3, line 19-21}.

AAPA fairly teaches the claimed invention except for the type of fee payment for subscription (registration) service from annual payment (\$35.00/year) to a one-time permanent registration fee with would result in an issuing of a permanent registration certificate (receipt) in step (c.), for example a payment of \$3,500 to cover 100 years or \$1,000,000 for perpetually permanent service).

In another subscription service, KORITZINSKY et al discloses several types of fee payment options (financial management arrangements) that may be provided to the subscriber for different levels of service, such as (a) pay-per-use, (b) periodically (yearly), or (c.) permanently, such as lifetime or non-expiring warranty service {see col. 21, lines 15-50}. In view of the general problems with respect to the expired subscribed service for the domain name registration as mentioned in the AAPA , it would have been obvious to modify the yearly/annual fee payment teachings of AAPA with a permanent fee payment as taught by KORITZINSKY et al to obtain the benefit of lifetime or non-expiring warranty service. Note that the type of subscription service in KORITZINSKY et al deals with subscribing to diagnostic system/service, however, the type of service or subscription service is not critical since fee payment arrangement can be applied in any subscription service. Moreover, the critical issue is “fee payment option” and facing with the problem of expiring of service due to non-payment, a skilled artisan would look to the teachings of fee payment options or different levels of service and if the service is so critical while the fee payment is so cheap, one would pick the permanent or lifetime or non-expiring warranty service to insure lifetime service. As for the difference in the type of subscription services, again, this is not critical and within the skill of the artisan since the major issue is the types of fee payment options for different levels of service. As for the limitation of “wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration”, this reads over the limitation “lifetime or non-expiring warranty service” of KORITZINSKY et al and is therefore inherently included in the teachings of KORITZINSKY et al above.



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As for the limitation of a certificate, this reads over the term "receipt of the service request" as shown in col. 21, line 24-26. As for the limitation "a permanent registration certificate", this is taught in AAPA / KORITZINSKY et al when "life time" service is selected/requested and the receipt of the service requested would inherently include the "permanent service".

6. As for dep. claim 2 (part of 1 above), which deals with well known computer readable medium having stored therein instructions for causing a processor to execute the steps of method claim 1, this is inherently included in the online system of AAPA /KORITZINSKY et al.

7. As for dep. claims 3, 9 (part of 1 above), which deals with well known information displaying parameters, i.e. certificate or receipt of fee payment for service, this is fairly taught in Fig. 1, Fig. 15, Fig. 8, "212", "PROBLEM DESCRIPTION".

8. As for dep. claims 12-13 (part of 1 above), which deals with well known payment parameters, i.e. electronically or manually, these are inherently included in the registration over the Internet as taught in AAPA. Alternatively, the manual payment of fee by mail or other would have been obvious because this is well known practice.

As for method claims 14-18, 19-20, 23-24, 25-29, 30-31, 32-33, which basically have the same limitations as in claims 1-3, 9, 12-13 above, they are rejected for the same reasons set forth above.

9. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA /KORITZINSKY et al as applied to claims 1-3, 9, 12-13, above, and further in view of MANN et al and CUMMINGS et al .

As for dep. claims 4-5 (part of 1 above), the teachings of AAPA /KORITZINSKY et al is cited above. MANN et al, as shown on col. 2, lines 4-18, is cited to disclose well known facts that many domain names have been registered by sellers/brokers as assets (equity) which may be sold for large sums of money for acquiring or transferring and using of the domain names to point to their content sources.

CUMMINGS et al is cited to teach well known business practice of obtaining insurance policy and title for an equity /asset to cover financial losses associated with the equity, thus protecting the equity/asset investment in case of losses {see col. 1, lines 15-20, claim 1}. It would have been obvious to modify the teachings of AAPA /KORITZINSKY et al by obtaining insurance policy and title as taught by CUMMINGS et al for the domain name registration to protect the domain names since MANN et al discloses that domain names are valuable assets/equity that can be sold for large sums of money.

10. Claims 6-8, 10-11, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA /KORITZINSKY et al as applied to claims 1-3, 9, 12-13, 19-20 above, and further in view of BURSTEIN et al.

As for dep. claims 6-8, 10-11 (part of 1 above) and 21-22 (part of 19 above), the teachings of AAPA /KORITZINSKY et al is cited above. BURSTEIN et al is cited to teach well known facts that many domain names have been registered by

sellers/brokers as assets (equity) which may be sold for large sums of money for acquiring or transferring and using of the domain names and many cases, the registrant may incorporate one or more domain names into an organization identity or business {see col. 2, lines 40-50}. As for dep. claims 6-8 and 10-11, which deal with well known business parameters for carrying out a business or corporation such as issuing shares, issuing leases or sub-leases of an asset, etc., and the practices of these business parameters in the teachings of AAPA /KORITZINSKY et al would have been obvious as routine business parameters.

#### ***Response to Arguments***

11. Applicant's arguments filed 6/12/06 have been fully considered but they are not persuasive.

In response to applicant's argument that AAPA and KORITZINSKY et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, In view of the general problems with respect to the expired subscribed service for the domain name registration as mentioned in the AAPA , it would have been obvious to modify the yearly/annual fee payment teachings of AAPA with a permanent fee payment as taught by KORITZINSKY et al to obtain the benefit of lifetime or non-expiring warranty service. Note that the type of subscription service in KORITZINSKY et al deals with subscribing to diagnostic system/service,

however, the type of service or subscription service is not critical since fee payment arrangement can be applied in any subscription service. Moreover, the critical issue is "fee payment option" and facing with the problem of expiring of service due to non-payment, a skilled artisan would look to the teachings of fee payment options or different levels of service and if the service is so critical while the fee payment is so cheap, one would pick the permanent or lifetime or non-expiring warranty service to insure lifetime service. As for the difference in the type of subscription services, again, this is not critical and within the skill of the artisan since the major issue is the types of fee payment options for different levels of service and subscription to diagnostic service is one of many teachings cited by KORITZINSKY et al.

As for the limitation of "wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration", this reads over the limitation "lifetime or non-expiring warranty service" of KORITZINSKY et al and is therefore inherently included in the teachings of KORITZINSKY et al above.

12.

No claims are allowed.

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

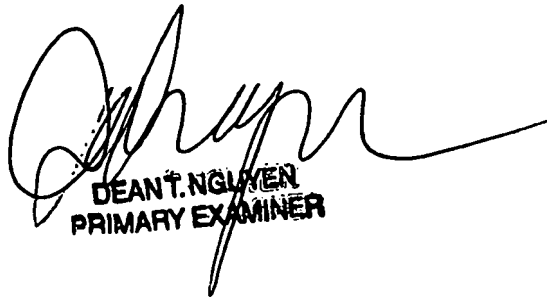
In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn  
August 21, 2006



DEAN T. NGUYEN  
PRIMARY EXAMINER



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(LHTLG No. 00,464-A)

In re Application of:

**Brown**

Serial No. **09/876,408**

Filed: **June 7, 2001**

For: **METHOD AND SYSTEM FOR  
PROTECTING DOMAIN  
NAMES**

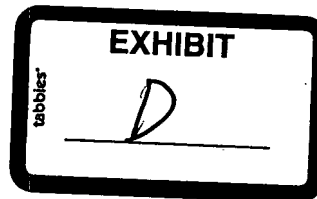
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Examiner: **Nguyen, Tan D.**

Group Art Unit: **3629**

Confirmation No. **7316**

MAIL STOP: Responses  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA. 22313-1450



**RESPONSE TO OFFICE ACTION**

**MAILED August 25, 2006**

Responsive to the First Office Action mailed August 25, 2006, Applicant  
submits the following Response.

**RESPONSE**

**Remarks**

Claims 1-33 are pending in the Application. Claims 1, 10, 16 and 20 are in  
independent format. Applicant now responds to the Examiner's assertions.

The Applicant has many grounds for which to appeal this matter and will file  
immediately a Notice of Appeal should the Examiner not reconsider the current  
rejections and withdraw them.

**Paragraph 11 – Response to Arguments in Previous Office Action**

The Applicant traverses all of the Examiner's assertions and accepts all of the Examiner's admissions.

The Applicant acknowledges that the Examiner admits he made a mistake in rejecting claims 1-33 on the ground that they infringed on U.S. laws set forth by Congress and the Applicant could not apply for any patent protection at all for any invention related to domain names since and the U.S. Department of Commerce was working under the authority of Congress and was under contract with ICANN for the domain name registration system that the U.S. Department of Commerce had no jurisdiction the domain name system for patent protection. The Applicant acknowledges that the Examiner withdraw this improper rejection.

In the previous Office Action, the Examiner, initially argued the claimed invention was obvious under 35 U.S.C. 103(a) as being unpatentable over Mann (U.S. Patent No. 6,519,589) in view of KORITZINSKY (U.S. Patent No. 6,272,469) in view of Hagan (U.S. Patent No. 6,415,267).

The Examiner has not mentioned this rejection in the current office action. The Examiner has not stated as whether this rejection was withdrawn or is still in place. He only states that the Applicant's arguments to this rejection in the Applicant's response filed June 5, 2006 were not persuasive.

If the Applicant's argument were not persuasive, why did the Examiner not maintain this rejection? If the Applicant's arguments were persuasive, the Applicant requests the Examiner state for the record why they were.

Applicant requests the Examiner state for the record the status of this rejection from the previous office action with respect to the present office action.

The Applicant asserts the Examiner has mis-applied U.S. Patent Law and the associated rules several times by sending out the current Office Action. First, this second non-final rejection of this current Office Action is improper under the patent rules. Since the Applicant did not amend the claims in the previous Office Action, the Examiner was required under the patent rules to either allow all the claims or finally reject the claims. The Examiner's actions are improper and inequitable under the patent rules.

The Examiner, after reading the Applicant's previous response, commented only on the Applicant's arguments with respect to the single reference KORITZINSKY. The Examiner, apparently feeling KORITZINSKY is the Examiner best chance to reject the Applicant's claims based on the comments made by the Applicant's in its response, then created a brand new rejection over the Applicant's application itself and KORITZINSKY. The Examiner also did a new search and created new rejections with new references Cummings and Burstein. A new search was not appropriate or necessary since the Applicant did not amend the claims. These actions by the Examiner violate MPEP rule 706.07. MPEP Rules 706.07 clearly states:



*To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; Switching from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.*

The Examiner is requested to state for the record why he did not violate MPEP rule 706.07 , why he conducted a new search and why he raised new objections when the Applicant did not amend any claims.

#### **Section §112, 2<sup>nd</sup> Rejection**

Examiner has asserted that the Applicant's claim language in Claim 1 and Claim 19 is indefinite under 35 USC §112, 2<sup>nd</sup>, specifically the step of "accepting a one-time permanent registration fee" is vague and indefinite. The Applicant traverses this assertion.

#### **Section §112, 2<sup>nd</sup> Response**

Astonishingly, the Examiner has now asserted for the first time that the exact claim limitation of "accepting a one-time permanent registration fee" for a permanent registration of a domain name is vague and indefinite. This is of the claim elements the Examiner admitted on Pages 6, 9, 11 and in the previous Office Action (December 5, 2005) that KORITZINSKY failed to teach. The Examiner specifically admitted that KORITZINSKY "failed to teach using the permanent registration fee to be added to a financial instrument who profit can be used to perpetually pay future renewal fees."

It is also one of the claim elements that the Examiner has asserted in the present Office Action is taught by KORITZINSKY to make an obviousness rejection. In fact after making the §112 rejection, the Examiner on page 6 of the current Office Action asserts the critical issue is the “fee payment option and facing the problem of expiring service due to non-payment” and KORITZINSKY now inherently teaches this claim limitation to further bolster his obviousness rejection.

This rejection is very suspicious to the Applicant as self-serving by the Examiner to manufacture a §112 rejection so the Applicant is forced to amend Claim 1 to further fit the claim language into the obvious rejection being manufactured by the Examiner.

The Applicant declines to amend the Claims and submits the claim language as filed is clear and definite as filed and as examined without rejection in the previous office action by the Examiner. The Applicant will point out this suspicious rejection to the Appeals Board.

#### **First Section 103 Rejection**

Claims 1-3, 9, 12-13, 14-18, 19-20, 23-24, 25-29 30-31 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable of AAPA in view of KORITZINSKY (U.S. Patent No. 6,272,469).

The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

Thus, there is clearly no motivation to combine the Applicant's Application and KORITZINSKY. Trying to do so violates the holdings of *In re Fine*, *In Re Gordon* and *In re Ratti*.

The Applicant has clearly shown why Claim 1 is not obvious over its own Application view of KORITZINSKY. The same arguments apply for independent claims 10, 16 and 20. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to independent Claims 1, 10, 16 and 20. Since these claims are not obvious they are all immediately allowable in there present form.

**Dependent Claims 2, 3, 9, 12-15, 17-19, 23-24, 25-29, 30-31 and 32-33**

The Examiner is reminded that if an independent claim is non-obvious under 35 USC 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988).

All of arguments for Claim 1 are incorporated by reference. All of the dependent claims add additional limitations not present the independent claims. The Applicant has clearly pointed out why the independent claims not obvious. Thus, the dependent claims are not obvious either under the holding of *In re Fine*.

### **Second Section 103 Rejection**

Claims 6-8, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of KORITZINSKY (U.S. Patent No. 6,272,469) in view of Cummings (U.S. Patent No. 6,470,321).

The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

### **Second Section 103 Response**

All of the arguments for Claim 1 above are incorporated by reference for Claims 4-5 and further apply in view of Cummings. The combination of these three references still does not teach or suggest the claimed invention claimed by Claims 4-5 either alone or in combination thereof.

Thus, Claims 4-5 are not obvious. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 4-5 in view of Cummings. Since these claims are not obvious they should all be immediately allowable in its present form.

### **Third Section 103 Rejection**

Claims 6-8, 10-11 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Claims 6-8, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of KORITZINSKY (U.S. Patent No. 6,272,469) in view of Burnstein (U.S. Patent No. 7,076,541).

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The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

### **Third Section 103 Response**

All of the arguments for Claim 1 above are incorporated by reference for Claims 6-8, 10-11 and 21-22 and further apply in view of Burnstein. The combination of these three references still does not teach or suggest the claimed invention claimed by Claims 6-8, 10-11 and 21-22 either alone or in combination thereof.

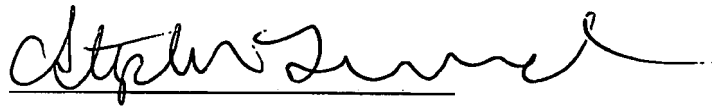
Thus, Claims 6-8, 10-11 and 21-22 are not obvious. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 6-8, 10-11 and 21-22 in view of Cummings. Since these claims are not obvious they should all be immediately allowable in its present form.

### CONCLUSION

The prior art made of record in the Office Action but not relied upon by the Examiner is no more pertinent to Applicant's invention than the cited references for the reasons given above. The Applicant therefore submits that all of the claims in their present form are immediately allowable and requests the Examiner withdraw the §112 rejection and all the §103 rejections of claims 1-33 and pass all of the claims immediately to allowance.

Respectfully submitted.

**Lesavich High-Tech Law Group, PC (32097)**



Dated: February 13, 2 007

Stephen Lesavich, PhD

Reg. No. 43,749



# UNITED STATES PATENT AND TRADEMARK OFFICE



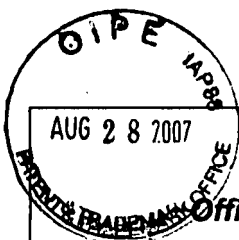
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,408	06/07/2001	Charles P. Brown	00,464-A	7316
32097 7590 05/18/2007 LESAVICH HIGH-TECH LAW GROUP, P.C. SUITE 325 39 S. LASALLE STREET CHICAGO, IL 60603			EXAMINER NGUYEN, TAN D	
			ART UNIT 3629	PAPER NUMBER
			MAIL DATE 05/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.





AUG 28 2007

## Office Action Summary

Application No.

09/876,408

Applicant(s)

BROWN, CHARLES P.

Examiner

Tan Dean D. Nguyen

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_



**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments, see pages 2-14, filed Feb. 13, 2007, with respect to the previous 112, 2<sup>nd</sup> and 103 rejections have been fully considered and are not persuasive since they are merely applicant's allegations, see paragraphs 11-13 below.

Claims 1-33 are pending and rejected as followed.

***Claim Rejections - 35 USC § 112***

2. Claims 1-13, 19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 5, the 2<sup>nd</sup> step of "accepting a one-time permanent registration fee" is vague and indefinite. From the specification, it appears this phrase appears to mean "accepting a one-time permanent registration fee payment" and therefore, insertion of the term "payment" after "fee" is recommended to improve clarity.

Similarly, claims 19-24, are rejected for the same reasons set forth in claims 1-13 above.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 1-3, 9, 12-13, 14-18, 19-20, 23-24, 25-29, 30-31, 32-33, which are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of KORITZINSKY et al.**

**Claim 1 is as followed:**

1. A method for protecting domain name registrations with a permanent registration certificate, comprising:

accepting information associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system;

accepting a one-time permanent registration fee for the domain name registration on the permanent domain name registration system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration; and

issuing a permanent registration certificate for the domain name registration based on the accepted information, wherein the permanent registration certificate provides a

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permanent registration the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system.

Claim 1 reads over:

A method for protecting a subscription service with a permanent service certificate wherein the service is domain name registrations subscription, comprising:

accepting information associated with a subscription service, wherein the subscription service is domain name registration obtained from a public domain name registrar on a domain name registration system;

accepting a one-time permanent registration fee for the subscription service wherein the subscription service is domain name registration, on a permanent subscription service system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the subscription service; and

issuing a permanent service certificate based on the accepted information, wherein the subscription service is domain name registration, and the permanent service certificate is about domain name registration and the certificate provides a permanent registration the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system.

As shown under the "Background of the Invention" in the specification, the domain name registration basically is subscription service that identifies and protect the IP addresses to make it easier for people to identify the sites on the Internet. Every year, each subscriber has to pay \$35.00/year for the maintaining of the service {see page 4, last paragraph}.

Similarly, as indicated in the specification, under "Background of the Invention", **AAPA** fairly discloses a method for domain name registrations service with a annual registration receipt (certificate), comprising:

(a) accepting information associated with a domain name registration (subscription service) obtained from a public domain name registrar on a domain name registration system {see page 3, last two paragraphs};

(b) accepting a yearly (annual) payment of registration fee for the domain name registration (subscription service) on the annual domain name registration system {see page 4, last paragraph}; and

(b) issuing an annual registration certificate (receipt) for the domain name registration based on the accepted information {see pages 4-6, see "a domain name can registered electronically at nsi.com" on page 3, line 19-21}.

AAPA fairly teaches the claimed invention except for the type of fee payment for subscription (registration) service from annual payment (\$35.00/year) to a one-time permanent registration fee with would result in an issuing of a permanent registration certificate (receipt) in step (c.), for example a payment of \$3,500 to cover 100 years or \$1,000,000 for perpetually permanent service).

In another subscription service, KORITZINSKY et al discloses several types of fee payment options (financial management arrangements) that may be provided to the subscriber for different levels of service, such as (a) pay-per-use, (b) periodically (yearly), or (c.) permanently, such as lifetime or non-expiring warranty service {see col. 21, lines 15-50}. In view of the general problems with respect to the expired subscribed service for the domain name registration as mentioned in the AAPA , it would have been obvious to modify the yearly/annual fee payment teachings of AAPA with a permanent fee payment as taught by KORITZINSKY et al to obtain the benefit of lifetime or non-expiring warranty service. Note that the type of subscription service in KORITZINSKY et al deals with subscribing to diagnostic system/service, however, the type of service or subscription service is not critical since fee payment arrangement can be applied in any subscription service. Moreover, the critical issue is "fee payment option" and facing with the problem of expiring of service due to non-payment, a skilled artisan would look to the teachings of fee payment options or different levels of service and if the service is so critical while the fee payment is so cheap, one would pick the permanent or lifetime or non-expiring warranty service to insure lifetime service. As for the difference in the type of subscription services, again, this is not critical and within the skill of the artisan since the major issue is the types of fee payment options for different levels of service. As for the limitation of "wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration", this reads over the limitation "lifetime or non-expiring warranty service" of KORITZINSKY et al and is therefore inherently included in the teachings of KORITZINSKY et al above.

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As for the limitation of a certificate, this reads over the term "receipt of the service request" as shown in col. 21, line 24-26. As for the limitation "a permanent registration certificate", this is taught in AAPA / KORITZINSKY et al when "life time" service is selected/requested and the receipt of the service requested would inherently include the "permanent service".

6. As for dep. claim 2 (part of 1 above), which deals with well known computer readable medium having stored therein instructions for causing a processor to execute the steps of method claim 1, this is inherently included in the online system of AAPA /KORITZINSKY et al.

7. As for dep. claims 3, 9 (part of 1 above), which deals with well known information displaying parameters, i.e. certificate or receipt of fee payment for service, this is fairly taught in Fig. 1, Fig. 15, Fig. 8, "212", "PROBLEM DESCRIPTION".

8. As for dep. claims 12-13 (part of 1 above), which deals with well known payment parameters, i.e. electronically or manually, these are inherently included in the registration over the Internet as taught in AAPA. Alternatively, the manual payment of fee by mail or other would have been obvious because this is well known practice.

As for method claims 14-18, 19-20, 23-24, 25-29, 30-31, 32-33, which basically have the same limitations as in claims 1-3, 9, 12-13 above, they are rejected for the same reasons set forth above.

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9. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA /KORITZINSKY et al as applied to claims 1-3, 9, 12-13, above, and further in view of MANN et al and CUMMINGS et al .

As for dep. claims 4-5 (part of 1 above), the teachings of AAPA /KORITZINSKY et al is cited above. MANN et al, as shown on col. 2, lines 4-18, is cited to disclose well known facts that many domain names have been registered by sellers/brokers as assets (equity) which may be sold for large sums of money for acquiring or transferring and using of the domain names to point to their content sources.

CUMMINGS et al is cited to teach well known business practice of obtaining insurance policy and title for an equity /asset to cover financial losses associated with the equity, thus protecting the equity/asset investment in case of losses {see col. 1, lines 15-20, claim 1}. It would have been obvious to modify the teachings of AAPA /KORITZINSKY et al by obtaining insurance policy and title as taught by CUMMINGS et al for the domain name registration to protect the domain names since MANN et al discloses that domain names are valuable assets/equity that can be sold for large sums of money.

10. Claims 6-8, 10-11, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA /KORITZINSKY et al as applied to claims 1-3, 9, 12-13, 19-20 above, and further in view of BURSTEIN et al.

As for dep. claims 6-8, 10-11 (part of 1 above) and 21-22 (part of 19 above), the teachings of AAPA /KORITZINSKY et al is cited above. BURSTEIN et al is cited to teach well known facts that many domain names have been registered by

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sellers/brokers as assets (equity) which may be sold for large sums of money for acquiring or transferring and using of the domain names and many cases, the registrant may incorporate one or more domain names into an organization identity or business {see col. 2, lines 40-50}. As for dep. claims 6-8 and 10-11, which deal with well known business parameters for carrying out a business or corporation such as issuing shares, issuing leases or sub-leases of an asset, etc., and the practices of these business parameters in the teachings of AAPA /KORITZINSKY et al would have been obvious as routine business parameters.

### ***Response to Arguments***

11. Applicant's arguments filed 2/13/2007 have been fully considered but they are not persuasive since they are merely applicant's opinions/allegations.

In response to applicant's argument that AAPA and KORITZINSKY et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, In view of the general problems with respect to the expired subscribed service for the domain name registration as mentioned in the AAPA , it would have been obvious to modify the yearly/annual fee payment teachings of AAPA with a permanent fee payment as taught by KORITZINSKY et al to obtain the benefit of lifetime or non-expiring warranty service. Note that the type of subscription service in KORITZINSKY et al deals with subscribing to diagnostic system/service,



however, the type of service or subscription service is not critical since fee payment arrangement can be applied in any subscription service. Moreover, the critical issue is "fee payment option" and facing with the problem of expiring of service due to non-payment, a skilled artisan would look to the teachings of fee payment options or different levels of service and if the service is so critical while the fee payment is so cheap, one would pick the permanent or lifetime or non-expiring warranty service to insure lifetime service. As for the difference in the type of subscription services, again, this is not critical and within the skill of the artisan since the major issue is the types of fee payment options for different levels of service and subscription to diagnostic service is one of many teachings cited by KORITZINSKY et al.

As for the limitation of "wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration", this reads over the limitation "lifetime or non-expiring warranty service" of KORITZINSKY et al and is therefore inherently included in the teachings of KORITZINSKY et al above.

12. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

13. As for the request of the examiner to list the reason why the Examiner has violated MPEP rule 706.07 cited by the applicant on page 4 of the response of 2/13/07, there are two issues:

(1) the examiner requested the applicant to cite where in the MPEP rule 706.07 with respect to the specific citation by the applicant ... "To bring the prosecution ... or a final rejection", the examiner has a hard time finding this citation/argument, and

(2) the examiner has made the 2<sup>nd</sup> non-final rejections of 8/25/06 for the reason stated above, see paragraphs no. 5-10.

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

No claims are allowed.

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15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

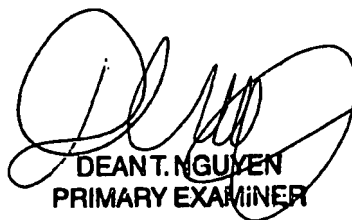
In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn  
May 14, 2007



DEAN T. NGUYEN  
PRIMARY EXAMINER